23-352
Submitted
Feb. 3rd 1875

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. ~~452.~~ 168

HENRY J. REEDY, APPELLANT,

vs.

GEORGE SCOTT.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF OHIO.

FILED JULY 19, 1873.

Oct. 2, 1874

SUPREME COURT OF THE UNITED STATES.

No. 452.

HENRY J. REEDY, APPELLANT,

vs.

GEORGE SCOTT.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF OHIO.

INDEX.

	Original.	Print.
Answer	12	6
Appeal-bond	60	26
Bill of complaint	1	1
Supplemental	8	4
Amendment to	16	8
Clerk's certificate to transcript	62	27
Deposition of S. S. Fisher	36	16
Deposition of Henry J. Reedy	23, 52	11, 23
Entries	7, 8, 11, 16, 22, 59.	4, 6, 8, 10, 11, 26
Exhibit S. S. F., No. 1, to deposition of S. S. Fisher	46	20
Exhibit S. S. F., No. 2, to deposition of S. S. Fisher	47	21
Plea and answer	19	9
Return of marshal to subpœna	7	3
Security for costs of writ	5	3
Subpœna	5	3

1 At a circuit court of the United States within and for the sixth judicial circuit and southern district of Ohio, begun and held at the court-house, in the city of Cincinnati, on the first Tuesday of April, being the first day of that month, in the year of our Lord one thousand eight hundred and seventy-three, and of the Independence of the United States of America the ninety-seventh. Present: the honorable Noah H. Swayne, associate justice, the honorable H. H. Emmons, and the honorable Philip B. Swing, judges of said court.

Among the proceedings had were the following, to wit:

HENRY J. REEDY
vs.
GEORGE SCOTT. } 1434. Chancery.

Be it remembered that heretofore, to wit, on the 20th day of January, in the year of our Lord one thousand eight hundred and seventy-one, came Henry J. Reedy, the complainant herein, by Wood & Boyd, his solicitors, and filed in the clerk's office of the court aforesaid his bill herein, which said bill is in the words and figures following, to wit:

Bill.

United States circuit court, southern district of Ohio.—In equity.

HENRY J. REEDY
vs.
GEORGE SCOTT.

To the honorable judges of the circuit court of the United States in and for the southern district of Ohio, in chancery sitting:

2 Your orator, Henry J. Reedy, of the city of Cincinnati, in said southern district of Ohio, brings this his bill of complaint against George Scott, and says that, heretofore, to wit, before the 9th day of June, 1868, he was the original and first inventor of a new and useful "improvement in hoisting-machines," for which, having complied with all requirements of law, he obtained in due form letters-patent of the United States, dated June 9th, 1868, No. 78829, all of record in the Patent-Office of the United States, an exemplified copy of which your orator is ready and willing to produce in court when required; whereby was granted to your orator, his executors, administrators, or assigns the full and exclusive right and liberty of making, using, and vending to others to be used, the said improvement in hoisting-machines.

Your orator further avers that said patented invention is and always was of great value and utility to the public; that it has been made and sold by him, his agents, and licensees extensively, in various parts of the United States, and has ever worked well.

Your orator further avers that said George Scott, who he prays may be made a defendant herein, well knowing all the premises aforesaid, and being fully aware of your orator's rights under said patent as herein stated, but without your orator's leave or license, and contrary to his will and in violation of his rights under his said patent, has made, constructed, used, and vended to others to be used, in various parts of the United States, the invention of your orator so patented as

3 aforesaid, all since the date thereof, to wit, June 9th, 1868;

that he has made and sold many hoisting-machines, the same in principle and mode of operation as the invention so patented to your orator as aforesaid, the exact number being unknown to your orator.

Your orator further says that he is himself making and selling said patented invention in Cincinnati aforesaid, and said infringing, use, and sale by said defendant detracts from his sale and business, and seriously injures his trade and rights under said patent, and if continued will ruin his said business.

Your orator further avers that defendant has been duly notified of your orator's rights under said patent, but he neglects and refuses to cease his infringement, and is proceeding to increase and enlarge his infringing manufacture and sale aforesaid.

Your orator, therefore, prays that your honors will take his case into consideration; that process of subpœna may issue herein against said George Scott; that he may be made a defendant to this bill, and may answer the same under oath, as fully as if herein specially interrogated; that he may be compelled to describe the form of the hoisting-machines he has made and sold, complained of by your orator as aforesaid, and illustrate the same by accurate description, models, or drawings, and may state in his said answer how many such he has made, and how many he has sold, and how many he has used, and what prices he has realized therefor, and what profit he has made on each hoisting-
4 machine so sold, used, or made, that this cause may be referred to a commissioner of this court, and an accurate account may be taken of the infringing hoisting-machines so made, sold, or used by defendant, and the unlawful gain and profit he has made thereby; that the same may be decreed to be by him paid over to your orator; that he may have a further decree against said defendant for all damages he has suffered by reason of said infringement; that all such infringing hoisting-machines, so made and in use by the defendant and found in his possession, may be given up to your orator and ordered to be destroyed; that until the final hearing of this bill a preliminary injunction may be granted your orator against the defendant, restraining him, his agents, and servants from further making, using, or selling the infringing hoisting-machines aforesaid, in violation of your orator's said patent; that on final hearing such injunction may be made perpetual, and that your orator may have all such other and further relief, orders, and decrees in the premises as may be needed to protect his said rights and as to your honors may seem meet; and your orator will ever pray, &c.

E. E. WOOD,
Solicitor for Comp't.

STATE OF OHIO,
Hamilton County, ss:

5 Henry J. Reedy, being duly sworn, deposes and says that all the matters and things stated in the foregoing bill as facts within his own knowledge are true, and such other matters as are from the information of others he believes to be true in substance and in fact.

HENRY J. REEDY.

Sworn to and subscribed in my presence this 13th day of October, 1870.

[SEAL.]

S. T. CRAWFORD,
Notary Public, Ham. Co., Ohio.

Upon which said bill is the following endorsement, to wit:

Security for costs.

Henry Smitt, of cor. Eighth & Eggleston avenue, Cincinnati, acknowledges himself security for all costs for which the complainant may become liable in this suit.

HENRY SCHMITT.

CINCINNATI, *Jan'y* 20, 1871.

And thereupon, on said 20th day of January, in the year last aforesaid, and in pursuance to the prayer of said bill, there was issued out of the clerk's office of said court the writ of subpœna against the said George Scott, the defendant herein, which said writ is in the words and figures following, to wit:

Subpœna.

UNITED STATES OF AMERICA,
Southern District of Ohio, ss:

The President of the United States of America to the marshal of the southern district of Ohio, greeting:

6 You are hereby commanded to summon George Scott, citizen of and resident in the State of Ohio, if he be found in your district, to be and appear in the circuit court of the United States for the southern district of Ohio aforesaid, at Cincinnati, on the first Monday in March next, to answer a certain bill in chancery filed and exhibited in said court against him by Henry J. Reedy, citizen of and resident in the State of Ohio.

Hereof you are not to fail under the penalty of the law thence ensuing, and have you then and there this writ.

Witness the honorable Salmon P. Chase, Chief Justice of the United States, this 20th day of January, A. D. 1871, and in the 95th year of the Independence of the United States of America.

Attest:
[SEAL.] JOHN McLEAN, *Clerk.*

MEMORANDUM.—The said defendant is required to enter his appearance in this suit in the clerk's office of said court, on or before the first Monday of March, 1871, otherwise the said bill may be taken pro confesso.

JOHN McLEAN, *Clerk.*

Upon which said writ is the following endorsement, to wit:
Henry Schmitt acknowledges himself security for all costs for which the plaintiff may be liable in this suit. (See bill.)

7 And afterwards, to wit, on the 31st day of January, in the year last aforesaid, came said marshal, to whom said writ was in form aforesaid directed, and returned the same into the clerk's office of said court, with his proceedings endorsed thereon in the words and figures following, to wit:

Marshal's return to subpœna.

I rec'd this writ @ 3 p. m. on the 20th day of January, 1871, and at 3.30 p. m. on the 20 day of January, 1871, served copy thereof personally upon the within-named George Scott.

W'M R. THRALL, *U. S. Marshal,*
By M. C. PICKERING, *Deputy.*

And afterwards, to wit, on the 8th day of March, in the year last aforesaid, an entry was made upon the journal of said court, in said cause, in the words and figures following, to wit:

Entry.

HENRY J. REEDY
vs. } 1434. Chancery.
GEORGE SCOTT.

The complainant having exhibited his bill of complaint herein, and said defendant having been duly served with process of this court, and having failed to put in an appearance as required, it is ordered that the said bill be taken as confessed.

And afterwards, to wit, on the 9th day of March, in the year last aforesaid, an entry was made upon the journal of said court, in
8 said cause, in the words and figures following, to wit:

Entry.

HENRY J. REEDY
vs. } 1434. Chancery.
GEORGE SCOTT.

On motion to the court, it is ordered that complainant herein have leave to file a supplemental bill, and that the default herein be set aside, and defendant has leave to plead, answer, or demur within thirty days.

And afterwards, to wit, but on the same day, and in the year last aforesaid, came the complainant, by Wood & Boyd, his solicitors, and filed in the clerk's office of said court his supplemental bill herein, which said supplemental bill is in the words and figures following, to wit:

Supplemental bill.

United States circuit court, southern district of Ohio.—In equity.

HENRY J. REEDY
vs. } 1434.
GEORGE SCOTT.

To the honorable the judges of the circuit court of the United States in and for the southern district of Ohio, in chancery sitting:

Your orator, Henry J. Reedy, of Cincinnati, in the said district of Ohio, respectfully represents unto your honors that on or about the 20th day of January, 1871, he exhibited his bill of complaint in this honorable court against George Scott, showing that your orator was the original and first inventor of a new and useful improvement in hoisting-machines, for which he received letters-patent of the United States,
9 dated June 9th, 1868, No. 78829, whereby was secured to your orator the exclusive right and liberty of making, using, and vending to others to be used, said improvement; and further showing unto your honors that the said George Scott, whom he prayed might be made a party defendant therein, well knowing your orator's rights as

therein shown, had, without your orator's leave or license, made, constructed, used, and vended to others to be used, the invention of your orator, so patented as aforesaid, and thereby praying that the said George Scott should be decreed to account for the profits arising from said manufacture, &c., and that an injunction might be granted restraining him from further making, &c., said hoisting-machines, and that your orator might have such other relief as therein specially prayed for, or as to your honors should seem meet.

Your orator further represents that the said George Scott has appeared, but has not put in his answer to the said bill, though duly summoned so to do, as by the records of this honorable court will more fully appear.

Your orator further represents, by way of supplement, that since the filing of said bill, he made a formal surrender of said letters-patent to the Commissioner of Patents of the United States, according to the statute in such case made and provided, for the purpose of obtaining a re-issue thereof for the same invention, upon a specification, accompanied with drawings and figures of said machine, describing the said
10 invention, and pointing out in what it consists in more full, clear, and exact terms than was done in the original specification; and thereupon, on the 21st day of February, 1871, a re-issue of said letters-patent was granted by the said Patent-Office, in due form of law, for the same invention described in said original patent, whereby was granted to your orator, and his legal representatives, the exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvements in hoisting-machines.

Your orator further avers that said George Scott, without your orator's leave or license, and contrary to his will, and in violation of his rights under his said re-issued letters-patent, has made, constructed, used, and vended to others to be used, in various parts of the United States, the invention of your orator, so patented as herein aforesaid, all since the date of said re-issue, which is of record in Patent-Office of the United States, and is numbered 4273.

Your orator therefore prays, in addition to the prayer of his said original bill herein, that your honors will take his case into consideration as presented by this supplement; that said George Scott may answer this supplement, under oath, as fully as if herein specifically interrogated; and your orator will ever pray, &c.

WOOD & BOYD,
Sol's for Comp't.

11 STATE OF OHIO,
Hamilton County, ss:

Henry J. Reedy, being duly sworn, deposes & says that all and singular the allegations in the foregoing bill are true to his own knowledge, except so far as they are set forth upon his information, and such he verily believes to be true.

HENRY J. REEDY.

Sworn to and subscribed before me this 8th day of March, 1871.
[SEAL.] HERMAN MERRELL,
A Notary Public, Ham. Co., Ohio.

And afterwards, to wit, on the 9th day of May, in the year last aforesaid, an entry was made upon the journal of said court, in said cause, in the words and figures following, to wit:

Entry.

HENRY J. REEDY
vs.
GEORGE SCOTT. } Chancery.

On motion to the court, it is ordered that the decree pro confesso heretofore entered in this cause be, and the same hereby is, set aside, and defendant has leave to file his answer herein forthwith; and the same is accordingly filed. And which said answer is in the words and figures following, to wit.

12 *Answer.*

UNITED STATES OF AMERICA:

In the circuit court of the United States, southern district of Ohio.

HENRY J. REEDY, COMPLAINANT,
vs.
GEORGE SCOTT, DEFENDANT. } In chancery.

The plea of the above-named defendant, George Scott, to the bill of complaint, and supplemental bill of the above-named complainant.

This defendant, by protestation, not confessing or acknowledging all or any of the matters or things in the said bill of complaint and supplemental bill contained to be true, in such manner and form as the same are therein set forth and alleged, doth plead thereto.

And for plea, this defendant says that on the twentieth day of January, in the year eighteen hundred and seventy-one, at the district aforesaid, after the filing in this court of said bill of complaint, the plaintiff and defendant entered into a certain agreement in writing of that date, under their hands and seals, wherein it was recited that whereas Henry J. Reedy, the plaintiff, is the owner of letters-patent No. 78829, for an improvement in hoisting-machines, granted June 9, 1868, and whereas George Scott, the defendant, is the owner of letters-patent No. 81299, for an improvement in elevators, dated August 18, 1868, and is
13 building hoisting-machines claimed to be manufactured under said patent and a pending application, but which it is claimed by said Henry J. Reedy, the complainant, are an infringement of his aforesaid letters-patent No. 78829; and whereas said Reedy, the complainant, has filed a bill in equity against said Scott, the defendant in case No. 1434, in the circuit court of the United States for the southern district of Ohio; and whereas the parties are desirous of avoiding the expense and delay of litigation, it was thereby, then and there, between said Henry J. Reedy, the complainant, and the said George Scott, the defendant, mutually agreed to submit to Samuel S. Fisher the question whether the machine manufactured by said Scott, the defendant, is or is not an infringement of the said letters-patent No. 78829, and to abide by his decision of said question; that is to say, if said Fisher should decide said machine to be an infringement, the said Scott agreed to abandon the manufacture of said machines, and to make no more of them in any part of the United States, and if said Fisher should decide that said machine is not an infringement of said patent, then said Reedy, the plaintiff, agreed that the bill in said suit No. 1434 should stand dis-

missed at his cost, and that he would not molest the said Scott, the defendant, in the manufacture of said machines.

And the defendant says that the said bill in equity and suit of the said Reedy in said agreement mentioned is the original bill of complaint in this suit.

14 And the defendant further says that, in pursuance of said agreement, the said parties, the said Henry J. Reedy, the plaintiff, and the said George Scott, the defendant, personally appeared before the said Samuel S. Fisher, on the day aforesaid, at Cincinnati, in the said district, and then and there submitted to him for his arbitration and decision the said question, and their respective claims in reference thereto and their said patents, the said Fisher having then and there taken upon himself the burden of said arbitration; and the said parties having been fully heard by him upon the same, the said Fisher thereupon afterwards, to wit, on the 21st day of January, 1871, made and published his decision and award therein in writing, wherein he found and decided in answer to the said question so submitted to him as aforesaid, that the machine manufactured by George Scott, the defendant, is not an infringment of the letters-patent No. 78829 for an improvement in hoisting-machines granted to Henry J. Reedy, the plaintiff, June 9, 1868; a copy of which decision, finding, and award was thereupon immediately by the said Fisher delivered to each of said parties, and by reason thereof the plaintiff became and was bound to cause his said original bill herein to be dismissed at his costs, and not further to molest the defendant in the manufacture of the said machine.

All which matters and things this defendant avers to be true, and pleads the same to the said bill and supplemental bill, and prays

15 the judgment of this honorable court whether he shall be compelled to make any further or other answer thereto, and humbly prays to be hence dismissed with his reasonable costs in this behalf sustained.

C. B. SIMRALL,
MATTHEWS & RAMSEY,
Solicitors for Def't.

The undersigned, of counsel for the defendant, do hereby certify that in their opinion the foregoing plea is well founded in point of law.

C. B. SIMRALL,
MATTHEWS & RAMSEY,
Solicitors for Def't.

The above-named defendant, George Scott, being duly sworn, says that the facts stated in the foregoing plea are true, and that the same is not interposed for delay.

GEORGE SCOTT.

Subscribed and sworn to before me by George Scott, this 22nd day of April, A. D. 1871.

[SEAL.] W. A. MERRIWETHER,
Clerk Circuit Court of the U. S., K'y Dis't.

And afterwards, to wit, on the 26th day of May, in the year last aforesaid, an entry was made upon the journal of said court, in said cause, in the words and figures following, to wit:

16 *Entry.*

HENRY J. REEDY
vs.
GEORGE SCOTT. } 1434. Chancery.

On motion to the court, it is ordered that the complainant have leave to file in this cause an amendment to the bill hereinbefore filed, and the same is accordingly done.

And which said amendment is in the words and figures following, to wit:

Amendment to bill.

In the United States circuit court for the southern district of Ohio.

HENRY J. REEDY
vs.
GEORGE SCOTT. } 1434. In equity.

To the honorable the judges of the circuit court of the United States for the southern district of Ohio, in chancery sitting:

Your orator, Henry J. Reedy, now comes and by way of a further supplement to his original bill, and as an amendment to his first supplement, represents that after the filing of his said bill, and on or about the 20th day of January, 1871, at the request and upon the suggestion of the defendant, he accompanied the defendant to the law-office of Samuel S. Fisher, esq., a solicitor of this court, for the purpose of hearing his opinion upon the question of infringement stated in said bill; that after a statement of your orator's claims under his said original patent,
17 it was agreed between the parties hereto to submit in writing the whole question of said infringement for the opinion of said Fisher; that said Fisher then drew up an agreement in writing which your orator and defendant signed, but which your orator did not understand to make the further prosecution of this suit dependent upon the opinion to be given by said Fisher; that your orator executed said agreement without consulting his solicitors in this suit and without knowing the effect of said agreement; that as soon as your orator became advised of the nature of said agreement and its possible effect, to wit, on the morning of the 21st day of January, 1871, said agreement having been executed the evening previous, he went to the office of said Fisher for the express purpose of revoking any and all authority given to him by said agreement, but said Fisher was not in his office, and your orator was informed by the law-partner of said Fisher that he would not be in the city till late that afternoon; that your orator then took away from the office of said Fisher his said original letters-patent, and did not return them for the purposes of said opinion; that on the afternoon of the said 21st day of January, 1871, and before the making or signing of the pretended award hereinafter mentioned, your orator saw said Fisher at his office, and explained to him that he was mistaken as to the nature and effect of the said agreement signed the evening previous, and
18 that he did not wish said Fisher to act thereunder, and at the same time served him with a notice, in writing, revoking all authority and power given to him by said agreement; that notwithstanding said revocation and withdrawal of said letters-patent, which were

the only evidence of your orator's invention before said Fisher, said Fisher afterwards proceeded in the matter of said reference, and did afterwards make and deliver an opinion with reference to the infringement by defendant of the first clause of claims of said original letters-patent, but did not give any opinion or make any award as to the second clause of said claims, for an infringement of which, as well as the first, this suit was brought, and did not award, adjudge, or direct anything to be done by either of the said parties; that your orator was not notified of the sittings of said pretended arbitrator, nor was any opportunity given him to call witnesses, or to be heard in person or by counsel; and that it does not appear that the infringing machine of defendant was before said Fisher, or that any evidence of the same was offered or required by said Fisher.

Wherefore your orator prays as in and by his said bill and supplement he hath already prayed.

WOOD & BOYD,
Sol's for Compl't.

19 STATE OF OHIO,
Hamilton County, ss:

The above-named complainant, Henry J. Reedy, being duly sworn, says that all and singular the allegations in the foregoing amendment & supplement to bill are true to his own knowledge except so far as they are set forth upon information, and such he verily believes to be true.

HENRY J. REEDY.

Sworn to and subscribed before me this 23d day of May, 1871.
[SEAL.] HERMAN MERRELL,
A Notary Public, Ham. Co., Ohio.

And afterwards, to wit, on the 14th day of June, in the year last aforesaid, came George Scott, the defendant herein, by his solicitors, and filed in the clerk's office of said court his plea and answer to the bill of complaint and supplement bill, and bill by way of amendment and further supplement thereto, herein, which said plea and answer is in the words and figures following, to wit:

Plea & answer.

UNITED STATES OF AMERICA:

In the circuit court of the United States, southern district of Ohio.

HENRY J. REEDY, COMPLAINANT,
vs.
GEORGE SCOTT, DEFENDANT. } In chancery.

20 The plea of the above-named defendant, George Scott, to the bill of complaint and supplement bill, and bill by way of amendment, and further supplement thereto of the above-named complainant, and answer in support thereof.

This defendant now comes, and as to the said bill of complaint, and supplemental bill, and bill by way of amendment, and further supplement thereto of the said complainant, doth plead thereto, and for plea

thereto doth refile his plea heretofore filed to the said bill of complaint and supplemental bill, and in support of said plea, and by way of answer to the matters and things set forth and contained in the said bill by way of amendment and of further supplement of the complainant, says that it is not true, as therein alleged, that the complainant signed the said agreement to submit the said question to the decision of the said S. S. Fisher, not understanding the same to make the further prosecution of said suit dependent on said decision, and, on the contrary thereof, avers that the complainant signed the same with full knowledge and perfect understanding of the effect thereof, and particularly that the very purpose of signing the same was to put an end to this suit. And this defendant, in further answering, says that it is not true, as therein alleged, that the complainant revoked the authority of said Fisher, given him by said agreement, before said Fisher had made and published said decision and award; and said defendant, in further answering, says that it is not true, as therein alleged, that the
21 complainant was not notified of the sittings of said arbitrater, and that no opportunity was given the complainant to call witnesses or to be heard in person or by counsel; but, on the contrary, he avers that the complainant was personally present before said arbitrator at all his sittings held for the purpose of hearing said cause, and had full opportunity to and did in fact produce and offer all evidence he considered material to his claim, and was fully heard thereon by said arbitrator.

And by reason of the premises the defendant says that the complainant is barred from further prosecuting or maintaining this suit, and prays to be hence dismissed with his reasonable costs, &c.

MATTHEWS & RAMSEY, AND
C. B. SIMRALL,
Solicitors for Def't.

United States circuit court, district of Kentucky.

George Scott, being first duly sworn, says that the averments in his foregoing plea and answer are true.

GEORGE SCOTT.

Subscribed and sworn to before me this 7th day of June, 1871.
[SEAL.] W. A. MERREWETHER,
Com'r Cir. C't U. S., K'y Dist.

And afterwards, to wit, on the 12th day of October, in the year of our Lord one thousand eight hundred and seventy-two, an entry was made upon the journal of said court, in said cause, in the words and figures following, to wit:

Entry.

HENRY J. REEDY
vs.
GEORGE SCOTT. } 1434. Chancery.

This cause came on for hearing, on the motion of the complainant to strike out the defendant's plea and answer in support thereof for insufficiency, which motion having been argued and submitted, on consideration the court do overrule the same.

And afterwards, to wit, on the 6th day of March, in the year of our Lord one thousand eight hundred and seventy-three, an entry was made upon the journal of said court, in said cause, in the words and figures following, to wit:

Entry.

HENRY J. REEDY
vs.
GEORGE SCOTT. } 1434. Chancery.

By consent of parties, it is ordered that Herman Merrill be, and he hereby is, appointed a special examiner herein, and complainant is allowed ten days from the 13th of March to take testimony; 20 days thereafter for defendant to take his testimony, and complainant in rebuttal twenty days thereafter.

23 And afterwards, to wit, on the 22d day of March, in the year last aforesaid, there was filed in the clerk's office of said court the deposition of Henry J. Reedy, on behalf of the complainant herein, which said deposition is in the words and figures following, to wit:

Deposition of Henry J. Reedy.

Circuit court of the United States for the southern district of Ohio.

HENRY J. REEDY
vs.
GEORGE SCOTT. } In equity. No. 1434.

The defendant will take notice that the complainant will examine witnesses in the above-named cause, under the 67th rule in equity, as amended, before Herman Merrell, esq., special examiner, at the law office of Wood & Boyd, No. 53 West Third street, Cincinnati, on Thursday, the 13th day of March, 1873, beginning said examination at 10 o'clock a. m. of said day, and continuing from day to day until completed.

WOOD & BOYD,
Solicitors for Comp't.

Received copy.

C. B. SIMRALL,
Solicitor for Def't.

Circuit court of the United States for the southern district of Ohio.

HENRY J. REEDY
vs.
GEORGE SCOTT. } In equity. No. 1434.

24 Examination of witnesses on behalf of the complainant under the 67th rule in equity, as amended, pursuant to the annexed notice. Present, E. Boyd, esq., for the complainant, and C. B. Simrall, esq., for the defendant.

By request of parties it is ordered that these depositions be taken by question and answer.

HERMAN MERRELL,
Special Examiner.

HENRY J. REEDY, a witness produced on behalf of complainant, being first duly sworn, deposeth and saith, in answer to interrogatories propounded to him by E. Boyd, esq., of counsel for the complainant, as follows:

Question 1. State your name, age, residence, & occupation, & your connection with this suit.

Answer. My name is Henry J. Reedy. I am 32 years of age. I reside on Eggleston avenue, in Cincinnati. I am a maker of hoisting-machines. I am complainant in this suit.

Ques. 2. State if you are personally acquainted with the defendant, George Scott.

Ans. Yes, I know him.

Ques. 3. Please state whether, on or about the 20th day of January, 1871, you did, in company with said Scott, call on S. S. Fisher, esq., at his office in Cincinnati, for the purpose of asking his legal opinion on any subject.

25

Ans. Yes, I did.

Ques. 4. Please state fully how you happened to make this visit to Mr. Fisher, and what occurred while there.

Ans. Myself and Mr. Scott were in company that day. We called on George Johnson, and he advised us to call on Mr. Fisher, and ask his opinion. While there, in Mr. Fisher's office, the United States marshal served Mr. Scott with a summons to appear in the United States court, and to show cause why he had infringed on my patent hoister. We had previously asked Mr. Fisher for his opinion. When Mr. Fisher saw the United States marshal he declined to give any opinion except we would sign a paper. Then he wrote a paper which we signed.

Question 5. Please state whether or not the paper which you signed had a seal, scroll, or otherwise, or if you attached a seal of any kind thereto, following your signature.

Ans. I did not. The paper had no seal.

Ques. 6. Please state what documents, if any, you left in the possession of Mr. Fisher for the purpose of enabling him arrive at an opinion on the question submitted.

26

Ans. I left my patent.

Ques. 7. State more fully the nature of the paper which you signed, and the exact date if you can,

(Question objected to as incompetent.)

Ans. The date of the paper was January 20th, 1871. The object of the paper was, in case said Scott's hoisting-machine was an infringement on my patent, he, Scott, would abandon the making of said machine, and, if not, I was to withdraw the suit in the United States court.

Ques. 8. Please state when you next saw Mr. Fisher, and what was then done. [Also state what efforts, if any, you made to see him between the time of leaving his office, after signing the paper you have mentioned, and the time when you did next see him.]

(Question between brackets objected to as incompetent and irrelevant.)

Ans. I saw him on January 21st, in the evening. I then asked Mr. Fisher if he had come to any opinion between myself and Mr. Scott. He said not. I then told him to discontinue any further in the matter for me. He answered, he did not know if he could do so without Mr. Scott's consent. I told him I did not care, I wanted him to stop. He said he would continue. I asked him how he would continue, as I had

taken my patent away in the morning. He said it made no dif-
27 ference, as he could get my claim from the Patent-Office Report, which he took from the shelf, and showed me my claim. I then served him with a written revocation, revoking his authority to proceed any further. I tried to see him on the evening of January 20th, 1871, but he had gone home; that was about five o'clock in the evening. I intended to serve him with a revocation at that time. I tried also on the following forenoon, but he could not be found. Myself and Mr. Boyd *was* in his office in the morning of January 21st, and I then took my patent paper away from his office. They told me that Mr. Fisher would be in his office about four o'clock, at which time I served him with the revocation.

Ques. 9. If you have a copy of the revocation, which you say you served on Mr. Fisher, January 21st, 1871, please produce it; mark it complainant's Exhibit No. 1, and request the examiner to transcribe a copy of it as a part of your answer to this question.

Ans. I here produce a letter-press copy of the paper asked for, and request the examiner to transcribe a copy of it as a part of this answer. Said copy is as follows:

"JANUARY 21.

"Hon. S. S. FISHER:

"SIR: The paper which I signed in your office yesterday, re-
28 ferring to my claim against Mr. Scott for infringement of my patents, was not intended to effect my suit against him; and if it can be so construed, I now desire to hereby revoke all authority given you to act for me in any way.

"I only went to see you at request of Mr. Scott & for his satisfaction, and if I signed any paper cutting off my rights in court I did not so understand or intend it.

"Yours, &c.,

"HENRY J. REEDY."

HERMAN MERRELL, *Special Examiner.*

Ques. 10. By whom was the above notice signed?

Ans. It was signed by me, Henry J. Reedy.

Ques. 11. Please state if, notwithstanding this notice, you subsequently received a paper purporting to be the award or decision of Mr. Fisher upon the questions submitted to him; and, if so, state when you received it, and when you first saw it.

Ans. I received a paper by mail, January 29th, 1871, and I saw it first on the same day.

Ques. 12. What if anything was said by Mr. Fisher as to the re-issue sued on, covering the machine of the defendant?

(Objected to as incompetent.)

29 Ans. He said that if my patent was re-issued it would completely cover Mr. Scott's machine.

Ques. 13. State whether Mr. Fisher told you this before or after the 21st of January, 1871.

Ans. After.

And in answer to cross-interrogatories to him propounded by counsel for defendant, he deposeth & saith as follows:

1st x-ques. State when you first made your application for a re-issue; whether it was before or after Mr. Fisher's award.

Ans. Before I read the award.

2d x-ques. Was it before or after your agreement to arbitrate?

Ans. It was after.

3d x-ques. Was it before or after your pretended revocation of the arbitration?

Ans. It was after.

4th x-ques. Was it the object of your application to cover the machine of Mr. Scott, & make it an infringement of your patent hoisting-machine?

Ans. It was my object to substantially & clearly state the claims of my invention.

30 5th x-ques. I insist upon your answering whether or not it was the object of your application for a re-issue to cover the machine of Mr. Scott, as examined by Mr. Fisher, and so make it an infringement of your patent hoisting-machine.

(Question objected to, 1st, because it is immaterial; 2d, because the object of the application for the re-issue has been fully stated in the answer to the previous questions; and 3d, because a question of an infringement by the defendant's machine could not be settled by the witness or by a re-issue.)

Ans. It was not definately so intended.

6th x-ques. By whom was the letter making the pretended revocation written?

Ans. By Mr. Boyd, my attorney, I believe.

7th x-ques. Was it made after consultation with your counsel, and for what reasons was it made?

Ans. I told my counsel that I had signed a paper in Mr. Fisher's office. He told me to revoke it immediately. The reason was to have my patent re-issued, and my invention & claims definately described.

8th x-ques. State if Mr. Scott's visit to Cincinnati, at that time, was not for the purpose of settling these questions in controversy, and whether or not you did not, with Mr. Scott, visit or call upon

31 several persons with the object of submitting this question of infringement to reference.

Ans. Mr. Scott's visit was not to settle that difference between him and me. He came here to sell his patents. We called on no person in regard to submitting it to reference.

9 x-ques. What was your object in calling upon Mr. Fisher?

Ans. To get his opinion of the differences between the parties.

10th x-q. Did you not agree to refer the question of infringement to Mr. Fisher?

Ans. I did not understandingly.

11th x-ques. Did you not pay Mr. Fisher a fee for his services as referee or arbitrator?

Ans. I asked Mr. Fisher how much his trouble amounted to; he answered fifty dollars. I gave him a check for it.

12th x-ques. Was this before or after the arbitration by Fisher?

Ans. It was before I read his supposed award.

13th x-ques. Was it before or after you gave him the letter referred to in question 9, examination-in-chief?

Ans. It was after.

32 14th x-ques. Was the agreement to arbitrate which you signed in Mr. Fisher's office read to or by you before you signed it?

Ans. It was read by W'm H. Fisher in the room. I heard it.

15th x-ques. Did not Mr. Fisher refuse to proceed further in the matter unless you would agree to have the suit which you had brought against Scott dismissed in case his award should be against you and your patent?

Ans. He inserted that in the agreement. I don't remember whether he refused to proceed unless I agreed to that.

16th x-ques. Did he not refuse to proceed unless you would sign the paper that he drew up as an agreement to arbitrate?

Ans. I don't know that he did refuse.

17th x-ques. Was it not a condition in that paper that if the award should be in favor of Scott you would dismiss the suit you had brought against him, and that you would not molest him in the further manufacture of his machine?

(Objected as calling for secondary evidence.)

Ans. I believe there were such conditions stated in the agreement.

18th x-ques. Did you sign the paper?

33 Ans. I did, but not fully understanding its contents or importance.

19 x-ques. Who is the George Johnson whom you referred to in answer to ques. 4 of examination-in-chief?

Ans. He was a manufacturer of hoisting-machines on Columbia street, at the American Machine Shop. I do not know where he is now.

20th x-ques. Had you any reason to think or know that the decision of Fisher would be adverse to you when you attempted to revoke his authority?

Ans. I had no reason to know or think so.

21st x-ques. Was your suit against Scott commenced before or after you went with him to see Mr. Fisher on the 20th day of January, 1871?

Ans. It was commenced before. The marshal served him in the office of Mr. Fisher.

And in answer to questions in re-examination by counsel for complainant, he deposes & saith as follows:

1st re-ques. State whether or not you have ever again seen the paper which you signed in Mr. Fisher's office. I mean the original.

Ans. I have seen it. I mean a copy of it. I have not seen the original.

34 2d re-q. State whether or not the statements which you have made in cross-examination with relation to the contents of it, were made from your recollection of what it contained, or from more recently having read the copy which you mentioned having seen?

Ans. They were made from having read the copy recently. I never did understand that paper until about six months ago.

And in answer to interrogations in recross-examination by counsel for defendant, he deposeth and saith as follows:

1st re-x-q. Please state if you have a copy of the agreement to award and arbitration in your possession or the possession of your attorneys, and can you produce the same and make it a part of your deposition.

(Question objected to, and counsel assumes the responsibility of advising the witness that he is not bound to and need not produce & make a part of his deposition the paper called for in the question.)

(Counsel for the defendant objects to the assumption of responsibility by the counsel for Mr. Reedy.)

Ans. It is not in my possession. It is in my attorney's possession, Mr. George Pugh's, of Cincinnati. I refuse, upon the advice of my counsel, to make said copy a part of my deposition.

HENRY J. REEDY.

35 UNITED STATES OF AMERICA,
State of Ohio, County of Hamilton, ss:

I, Herman Merrell, a special examiner appointed under the 67th rule in equity, as amended by the circuit court of the United States for the southern district of Ohio, in the cause stated in the caption, do hereby certify that the foregoing examination was had pursuant to the annexed notice at the office of Wood & Boyd, No. 53 West Third street, Cincinnati, Ohio, on Thursday, the 13th day of March, 1873.

I further certify that at said time and place in said caption stated I was attended by Henry J. Reedy, a witness produced on behalf of the complainant, he being of sound mind and lawful age; and the said witness was, previous to the commencement of his deposition, carefully examined, cautioned, and solemnly sworn to testify the truth, the whole truth, and nothing but the truth, and the deposition hereinbefore appearing was by me reduced to writing in the presence of the said witness, and was read over by me to the said witness, and thereupon subscribed by him in my presence.

I further certify that I am not of counsel or attorney or relative of either of the parties to the cause, or in any manner interested in the event of the same.

In testimony whereof I have hereunto set my hand this 13th day of March, A. D. 1873.

HERMAN MERRELL,
Special Examiner.

36 And afterwards, to wit, on the 4th day of April, in the year last aforesaid, there was filed in the clerk's office of said court the deposition of S. S. Fisher, on behalf of the defendant herein, which said deposition is in the words and figures following, to wit:

Deposition of S. S. Fisher.

Circuit court of the United States for the southern district of Ohio.

SOUTHERN DISTRICT OF OHIO, *ss:*

Circuit court of the United States for the southern district of Ohio.

HENRY J. REEDY, COMPLAINANT,
vs.
GEORGE SCOTT, DEF'T. } In equity. 1434.

The complainant will take notice that on Wednesday, the 2nd day of April, 1873, the above-named defendant will examine witnesses in the above-named cause under the 67th rule in equity, as amended, before Herman Merrell, esq., special examiner, at the law-office of C. B. Simrall, S. W. cor. 3rd and Walnut street, Cincinnati, Ohio, beginning at 9 o'clock a. m. of said day, and continuing from day to day until completed.

C. B. SIMRALL,
Solicitor for Def't.

Received copy.

WOOD & BOYD,
Sol's for Compl't.

37 Circuit court of the United States for the southern district of Ohio.

HENRY J. REEDY
vs.
GEORGE SCOTT. } In equity. No. 1434.

Examination of witnesses on behalf of the respondent, under the 67th rule in equity, as amended, pursuant to the annexed notice.

Present, C. B. Simrall, esq., for the respondent, and E. B. Boyd, esq., for the complainant. By request of parties, it is ordered that these depositions be taken by question and answer.

HERMAN MERRELL,
Special Examiner.

S. S. FISHER, of lawful age, being first duly sworn, deposeth and saith in answer to interrogatories, to him propounded by C. B. Simrall, esq., counsel for the defendant, as follows, to wit:

1st ques. State your name, age, residence, and occupation?

Ans. My name is Samuel S. Fisher; age, 40 years; residence, Cincinati; occupation, attorney at law.

2nd ques. State whether or not in the practice of your profes-
38 sion you pursue any speciality, and, if so, what is it?

Ans. For the last seventeen years I have been engaged specially in the conduct & trial of cases arising under letters-patent for inventions, and for the last ten years have accepted no other business.

3d ques. State whether or not you are acquainted with the parties, plaintiff and defendant, in this action.

Ans. I am.

4th Q. Please state whether or not, on or about the 20th day of January, 1871, the plaintiff & the defendant in company, called upon you at your office, for the purpose of asking your opinion in reference to the dispute between them with regard to patent elevators; if so, please state the object of their call as expressed to you by them, & also state what was done in your office at that time.

Ans. On the evening of the 19th of January, 1871, the parties named in the question called in company at my office, in this city, and asked me if I could hear a case between them in relation to a hoisting-machine. I had never seen either of the parties before, & at first I was reluctant to hear the matter in controversy, stating to them that people were very rarely satisfied with the result of arbitrations. After some
39 conversation I agreed to sit as referee, but either the parties or myself were not ready to go on at the moment, and the matter was adjourned until the following day. The next day Mr. Scott came to the office a little in advance of Mr. Reedy, and shortly afterward a deputy marshal entered and served him with a subpoena in the present cause. Mr. Reedy was not, I think, present at the time of service, but came in a few moments later. The subpoena was shown to me, & I declined at once to proceed with the proposed arbitration, expressing some indignation that my office should have been used for the purpose of obtaining service on Scott after the proposal of the day before. Mr. Reedy, however, assured me that it was his desire that the arbitration should go on, & that all matters in controversy between the parties should be settled by me without the expense of litigation. He said that the suit had been brought & the service made on Scott by the advice of his counsel, so that, in case there should be a failure to carry out the arbi-

tration, he would have service upon Scott, who was a non-resident. After some conversation, at the request of both parties, I drew up an agreement, under seal, which was signed by them, which agreement was read to both parties once, & I think two or three times, & in addition its effect was verbally explained to them, the verbal explanation being to this effect: to Scott I said, "You understand, if I decide against
40 you, you must quit the manufacture of these machines, not only in this city, but everywhere;" and to Reedy I said, "If I decide against you, you must dismiss this suit immediately, and let Mr. Scott alone." Both parties stated that they so understood the matter. The parties then left & I examined the case, which was submitted to me upon the patent of Reedy & a model of the Scott machine. I think it was in the afternoon of the same day that the parties returned again to learn my decision. Although I had determined the case, I had prepared no written award, but proceeded to state to them verbally the conclusion to which I had come, accompanying it with an elaborate explanation and illustration of the law of combinations. I took great pains to make this as plain as I could, and both parties seemed at length to understand, and be satisfied with it. The next day I prepared a written opinion, a copy of which was made for both parties, & subsequently delivered to each of them. I charged them $100 for the service. Mr. Scott paid the amount at once; Mr. Reedy some short time after.

5th Q. Please examine the papers now shown you, marked Exhibit S. S. F., No. 1, & S. S. F., No. 2, and state what you know about them, and make them a part of your deposition.

Ans. This paper, Exhibit S. S. F., No. 1, is the original agree-
41 ment made by Henry J. Reedy & George Scott, in my presence, & referred to in my last answer, & Exhibit S. S. F., No. 2, is the original draft of my opinion & award in the case submitted to me by them. I make them a part of this deposition. Both papers are in my handwriting.

6th Q. Will you please state whether or not Mr. Reedy ever revoked your power to arbitrate this question; if so, how did he revoke it & when?

Ans. Mr. Reedy served me with a paper which I have not preserved, but which, as I recollect it, did purport to revoke his agreement to submit the matter to arbitration, upon the ground that he did not understand his right to carry on the suit to be submitted, as a result of the decision. This paper was handed me after the interview, in the presence of both parties, when I announced to them verbally the conclusion to which I had come, & as I now recollect after the draft of the award had been prepared and signed, but before it was copied or delivered to either of the parties.

And in answer to cross-interrogatories to him propounded by E. Boyd, esq., counsel for complainant, he saith:

1st x-q. Was it not in the afternoon of January 20th, 1871, that the paper marked S. S. F., No. 1, was executed?

42 Ans. It may have been so. I have no independent recollection of these dates, except as I have refreshed my memory by the papers themselves. I recollect the order of the transactions but cannot now undertake to say, except as a matter of impression, at what time of day each took place.

2nd x-q. It was executed, was it not, after the service of the subpoena mentioned by you?

Ans. It was.

3d x q. Do you recollect the time of day you left your office on that day, and where you went subsequently?

Ans. I do not.

4th x-q. Do you remember that you were not in your office until late in the afternoon of the following day?

Ans. I have no recollection of that fact.

5th x-q. Are you certain that Mr. Reedy returned to your office on the 20th of January, 1871, after executing Exhibit S. S. F., No. 1.?

Ans. I am not certain that it was on the same afternoon that the parties returned, though that is still my impression. I only wish to be understood as saying that they did return before I prepared my draft opinion.

43 6th x-q. How long after the preparation of Exhibit S. S. F., No. 2, was it before the copies were delivered to the parties?

Ans. I think Mr. Scott received his on the following day. I can give this date exactly, if desired, upon an examination of my books. I do not recollect how soon the opinion was delivered to Reedy. I have the date at which he paid his proportion, but as he subsequently became a client and we did other business for him, the date of payment would not be a certain criterion of the date of delivery as in case of Scott. I should think the opinion was delivered to Reedy a week or ten days after it was prepared. It may have been less or more.

7th x-q. Between the 21st of January, 1871, and the delivery of the copy of Exhibit S. S. F., No. 2, did you advise Mr. Reedy that the original was executed by you; and, if so, did you show it to him?

Ans. I did advise Mr. Reedy of the award at the time that he called upon me to serve the notice of revocation. After reading the notice I expressed some surprise at the statement therein that the dismissal of the suit was not involved. I remember saying, "You don't mean to tell me, Reedy, to my face, that you did not fully understand that you were to dismiss the suit?" He laughed, and said his counsel had told him that he ought to sign that paper & give it to me. I replied that I did not think I could regard it; that my decision was made, and I thought Mr. Scott had acquiesced such rights; that I ought now to publish the decision.

44 8th x-q. Were you not at the time Mr. Reedy served you with the notice of revocation, examining Patent-Office Reports; & did you not, in reply to a question by Mr. Reedy as to how you could proceed after he had withdrawn his patent, say in substance that the withdrawal of his patent would not make any difference, as you had the claim of his patent in the reports?

Ans. I have no recollection of the fact inquired of. I have frequent occasion to consult Patent-Office Reports, & may have been examining them. I should not have ventured to decide the rights of any man under a patent upon a mere inspection of the claims, although I believe that in drafting my opinion I copied the claim in controversy from the printed report.

9th x-q. Did you copy the claim, in your opinion, after Mr. Reedy served you with the notice?

Ans. I think not. Mr. Reedy came into the office during my absence from it, & took away his letters-patent. Upon my return, being advised of that fact by my partner, I thought it my duty to draw up the opinion & award at once, copying the claim, as I have stated, from the Report. It was subsequent to this date that Mr. Reedy returned & served me with the notice, as I now recollect.

10th x-q. What time of the day did you first appear in your office on the 21st of January, 1871?

Ans. I cannot tell. I usually reach my office a few minutes
45 before ten o'clock in the morning. I know of no reason why I should have been either earlier or later on that day than usual.

11th x-q. Please explain what you mean by your language in answer to 7th x-question: "I ought now to publish the decision."

Ans. To deliver copies of the award to each of the parties.

12th x-q. You have stated that you did other business for Mr. Reedy. You will now please state if you advised the surrender of the original patent No. 78829, for the purpose of obtaining a re-issue of the same. If you answer yea, you will please state further whether this was subsequent to the signing of your opinion, Exhibit S. S. F., No. 2.

(Objected to as irrelevant & immaterial by counsel for defendant.)

Ans. I did advise the surrender & re-issue of the patent named in the question, & an application was made & re-issue obtained through our office. I think I drew the claims. This advice was given & application made after the signing of the draft-opinion, S. S. F., No. 2.

13th x-q. Did you state to Mr. Reedy, in substance, that a re-issue would completely cover Scott's machine?

(Objected to as irrelevant & incompetent.)

46 Ans. I think not. I understood the Scott controversy to be terminated, but I advised Mr. Reedy that a re-issue would cure the defect that had prevented him from covering Scott's machine, & secure to him what appeared to be his real invention.

SAM'L S. FISHER.

Exhibit S. S. F., No. 1, to foregoing deposition.

Exhibit S. S. F., No. 1. *Exhibit S. S. F., No. 1.*
HERMAN MERRELL, *Spe. Ex'r.*

Whereas Henry J. Reedy is the owner of letters-patent No. 78829 for an improvement in hoisting-machine, granted June 9, 1868; and whereas George Scott is the owner of letters-patent No. 81299 for an improvement in elevator, dated August 18, 1868, and is building hoisting-machines claimed to be manufactured under said patent and a pending application, but which it is claimed by said Henry J. Reedy are an infringement of his aforesaid letters-patent No. 78829; and whereas said Reedy has filed a bill in equity against said Scott in case No. 1434, in the circuit court of the United States for the southern district of Ohio; and whereas the parties are desirous of avoiding the expense and delay of litigation: Now, therefore, the said Henry J. Reedy and George Scott have mutually agreed to submit to Samuel S. Fisher the question whether the machine manufactured by said
47 Scott is or is not an infringement of the said letters-patent No. 78829, and to abide by his decision of said question; that is to say, if said Fisher shall decide said machine to be an infringement, the said Scott agrees to abandon the manufacture of said machines, and to make no more of them in any part of the United States; and if said Fisher shall decide that said machine is not an infringement of said patent, then said Reedy agrees that the bill in said suit, No. 1434, shall stand dismissed at his cost, and that he will not molest the said Scott in the manufacture of said machine.

Witness our hands and seals this twentieth day of January, 1871.

HENRY J. REEDY. [SEAL.]
GEORGE SCOTT. [SEAL.]

Witness:
W'M H. FISHER.

Exhibit S. S. F., No. 2, to foregoing deposition.

Exhibit S. S. F., No. 2. *Exhibit S. S. F., No. 2.*
HERMAN MERRELL, *Spe. Ex'r.*

HENRY J. REEDY
vs.
GEORGE SCOTT. } Arbitration.

This case is submitted to me for decision as referee. The question presented by the agreement of the parties is whether the machine manufactured by George Scott is or is not an infringement of the letters-patent No. 78829, for an improvement in hoisting-machines,
48 granted to Henry J. Reedy, June 9, 1868.

The patent embraces two claims, but the controversy as to infringement is, by agreement, limited to the first, which reads as follows: "The combination, substantially as described, with a hoisting-platform of the suspending-rope E, weights H H, rollers d, sheaves F F, and shaft G, or their mechanical equivalents, by which the platform is both balanced and enabled to be elevated and depressed in the manner explained."

The mechanism involved in this claim may be briefly described as follows: The platform of an ordinary hoisting-machine is suspended in the bight of a long rope, about at mid-length of the latter. The two ends of the rope pass up, one on each side of the hatchway, to a sheave, the two sheaves being secured to the same horizontal shaft, which is caused to rotate by gearing, after passing over the sheaves each end of the rope described, and is attached to a weight or counterpoise. At the point where the rope passes under the platform a small roller is located, one on each side, to prevent the abrasion of the rope as it is drawn backward or forward. The rope may be caused to move under the platform by irregularities in the load or by one sheave taking up the rope faster than the other; and the purpose of passing the rope below the platform and of making provision to prevent its abrasion is, that by using the rope in this way the platform is more perfectly balanced under all conditions. Hence, the claim describes the mechanism not only as raising and depressing the platform, but as
49 "balancing" it; and it is in the performance of this latter function that the rollers, d, play their especial part.

The machine of Scott shows a platform hung in the bight or loop of a rope which passes under a beam directly over the centre of the platform, with which it is connected by two side stanchions. The ends of the rope are taken up to two sheaves on the same horizontal shaft, over which they pass, descending over two idle pulleys on one side of the machine to a single weight, to which both ends are fastened. At the point at which the rope passes under the beam of the platform there is a grooved metallic saddle, which holds up the ends of two levers which operate the safety-brake; the rope passes in the groove around this saddle, and in fact suspends the saddle in the loop or bight.

In my judgment, in so far as the function of elevating or depressing the platform by means of two ropes passing over two sheaves and attached to weights is involved in Reedy's claim of invention, the same function is performed in substantially the same way by the mechanism in Scott's machine. But Reedy's claim is not for the mechanism for elevating and depressing the platform disconnected from that for balancing it. On the contrary, the mechanisms for performing the two functions are claimed in combination and not otherwise.

It is well-settled law that a patent for a combination is not infringed unless all the parts of the combination are used by the alleged
50 infringer. He must use every element enumerated or must substitute a substantial equivalent for those omitted. The cases upon this subject are all one way. (Pratz v. Ruggles, 16 Peters, 336; Vance vs. Campbell, 1 Black, 427; Crompton v. Belknap Mills, 3 Fisher, 536.)

After careful examination I do not think that Scott uses the rollers d, or any equivalent for them. His rope does not pass under the platform. As the ends are not attached to separate weights, but to the same weight, there is no movement of the rope. It does not play any part in balancing the platform, which is simply suspended as from a single central point. He does not use a roller, but a gro'ved piece of metal; and while it is true that such a curved piece of metal, placed in the same place as the roller d, and aiding the rope in balancing the platform by diminishing the friction, would probably be an equivalent for the roller, yet I am clearly of opinion that, used as it is in Scott's organization, merely to enclose and sustain the ends of the brake-levers and performing no part in balancing the platform or in preventing the abrasion of the rope, it is not an equivalent of the rollers. It follows that Scott has omitted a material element of the combination patented to Reedy, and, consequently, has not infringed his patent.

I therefore find, in answer to the question submitted to me, that the machine manufactured by George Scott is not an infringement of the letters-patent No. 78829, for an improvement in hoisting-ma-
51 chines, granted to Henry J. Reedy, June 9, 1868.

SAM'L S. FISHER, *Referee.*

JANUARY 21, 1871.

UNITED STATES OF AMERICA,
State of Ohio, County of Hamilton, ss:

I, Herman Merrell, a special examiner, appointed under the 67th rule in equity as amended, by the circuit court of the United States for the southern district of Ohio, in the cause stated in the caption, do hereby certify that the foregoing examination was had pursuant to the annexed notice, at the office of C. B. Simrall, S. W. cor. 3rd and Walnut street, Cincinnati, Ohio, on Wednesday, the 2nd day of April, 1873.

I further certify that at said time and place in said caption stated I was attended by Samuel S. Fisher, esq., a witness, produced on behalf of the respondent, he being of lawful age and sound mind; and the said witness was, previous to the commencement of his deposition, carefully examined, cautioned, and solemnly sworn to testify the truth, the whole truth and nothing but the truth, and the deposition herein before appearing was by me reduced to writing in the presence of the said witness, and was read over by me to the said witness, and thereupon subscribed by him in my presence.

I further certify that I am not of counsel or attorney or rela-
52 tive of either of the parties to the cause, or in any manner interested in the event of the same.

In testimony whereof I have hereunto set my hand this 2d day of April, 1873.

HERMAN MERRELL,
Special Examiner.

And afterwards, to wit, on the 6th day of May, in the year last aforesaid, there was filed in the clerk's office of said court the deposition of Henry J. Reedy for complainant herein, which said deposition is in the words and figures following, to wit:

Deposition of Henry J. Reedy.

Circuit court of the United States for the southern district of Ohio.

HENRY J. REEDY
vs.
GEORGE SCOTT. } In equity. No. 1434.

The defendant will take notice that the complainant will examine witnesses in the above-named cause, under the 67th rule in equity as amended, before Herman Merrell, esq., special examiner, at the offices of Wood & Boyd, No. 53 West 3rd street, Cincinnati, on Tuesday, the sixth day of May, 1873, beginning said examination at 10 o'clock a. m. of said day, and continuing from day to day until completed.

WOOD & BOYD,
Solicitors for Comp't.

53 Received copy, and all objections as to time under this notice waived, it being given for May 6th to accommodate me.

C. B. SIMRALL,
Solicitor for Respondent for Def't.

Circuit court of the United States for the southern district of Ohio.

HENRY J. REEDY
vs.
GEORGE SCOTT. } In equity. No. 1434.

Examination of witnesses on behalf of the complainant, under the 67th rule in equity as amended, pursuant to the annexed notice.

Present E. Boyd, esq., for the complainant, and C. B. Simrall, esq., for the respondent.

By request of parties it is ordered that these depositions be taken by question and answer.

HERMAN MERRELL,
Special Examiner.

HENRY J. REEDY, of lawful age, being first duly sworn, deposeth and saith, in answer to interrogatories to him propounded by E. Boyd, esq., counsel for the complainant, as follows, to wit:

1st ques. You are the complainant who testified hereinbefore, are you not?

Ans. I am.

54 2d ques. State whether after signing the submission, Exhibit S. S. F., No. 1, on January 20th, 1871, and leaving Mr. Fisher's office, you returned in company with the defendant, or there met the defendant again; and, if so, when and how often.

Ans. I did not return in company with the defendant, nor did I meet him there afterwards.

3d ques. State whether Mr. S. S. Fisher at any time informed you and the defendant together, either verbally or otherwise, of his determination of the question submitted by said Exhibit S. S. F., No. 1.

Ans. He did not.

4th ques. I find the following in answer 4 of Mr. Fisher's deposition herein: "I think it was in the afternoon of the same day that the parties

returned again to learn my decision. Although I had determined the case, I had prepared no written award, but proceeded to state to them verbally the conclusion to which I had come, accompanying it with an elaborate explanation and illustration of the law of combinations. I took great pains to make this as plain as I could, and both parties seemed at length to understand and be satisfied with it." What do you say as to the truth of this quotation?

Ans. Myself and Mr. Scott were not in company in his office, or did he give me notice of his decision. There was no such explana-
55 tion or illustration given, nor was there any.

5th ques. Were you present when the deputy marshal served the defendant in this cause with subpœna to appear and defend?

Ans. I was. The marshal asked for Mr. Scott, and I pointed him out to the marshal in Mr. Fisher's office.

6th ques. Mr. Fisher in his deposition, now shown you, says that you said "that suit had been brought and the service made on Scott by the advice of 'your' counsel, so that in case there should be a failure to carry out the arbitration 'you' would have service upon Scott, who was a non-resident." What do you say as to this, and what steps, if any, had you taken in the cause prior to your interview with Mr. Fisher?

Ans. I did not say that was the object of bringing the suit. I had instructed my counsel in the fall of 1870 to bring the suit and have service on Mr. Scott.

7th ques. What was the nature of your interview with Mr. Fisher up to the time of the service by the marshal? Was it then changed; and who suggested the agreement to arbitrate?

Ans. The nature of our interview was, we wanted Mr. Fisher's verbal opinion. But when the marshal served Mr. Scott, Mr. Fisher suggested that he should draw up a writing, and he then drew up the Exhibit S. S. F., No. 1.

56 8th ques. About what time of day was this exhibit signed, as near as you now recollect?

Ans. Between four and five o'clock in the afternoon.

9th ques. When did you next see Mr. S. S. Fisher?

Ans. I saw him in the evening of the following day, when I served him with the revocation.

10th ques. How often did you call at his office between the time of signing Exhibit S. S. F., No. 1 and the service of the revocation on the following day? Whom did you see, and what were you told with reference to Mr. Fisher's absence, whereabouts, and probable return?

(Objected to as incompetent & irrelevant.)

Ans. I called on the evening of the 20th, twice in the forenoon of the 21st, and two times in the afternoon. Once I didn't find him and once I did find him. The office was closed on the evening of the 20th, & I saw no one. In the morning of the 21st I saw Mr. W'm H. Fisher, Mr. S. S. Fisher's law partner. He told me Mr. S. S. Fisher was in College Hill, visiting friends, and that he would not return before evening. On my first call in the afternoon I asked Mr. W'm H. Fisher if he had returned, and he told me he had not.

(Objected to as incompetent & irrelevant.)

11th ques. You will please read Mr. Fisher's answer to cross question 7, and state whether or not the statements there related were ever
57 made, and more particularly whether at the time you served him with the revocation he advised you of the award and said he ought to publish it.

Ans. He did not advise me of the award at that time; he had no

award made. I don't remember any such statements being made. I asked him if he had come to any opinion and he said not.

12th ques. When did he first advise you of the award, and what did he say?

Ans. I called at his office on the 23d of January, 1871, to pay him for his trouble, and he then told me he had decided against me. This was the first I heard or knew of his opinion. I gave him a check for the amount, which I now have.

13th ques. What, if anything, was then said by him as to the defendant having not paid his share of the charges?

(Objected to as incompetent & irrelevant.)

Ans. I asked him if the defendant paid him. He said not; his model was in the office yet.

(Objected to as incompetent & irrelevant.)

14th ques. Did you at any time after see the defendant's model in Mr. Fisher's office; and, if so, what reason, if any, was assigned for its presence there?

(Objected to as incompetent & irrelevant.)

Ans. I saw the model there. I understood from parties in the office, I don't know who, that he had to send to Louisville for money to pay his share.

58 (Objected to as incompetent & irrelevant.)

And in answer to cross-interrogatories to him propounded by counsel for respondent, he deposeth & saith as follows, to wit:

Cross-examination waived.

HENRY J. REEDY.

UNITED STATES OF AMERICA,
State of Ohio, County of Hamilton, ss:

I, Herman Merrell, a special examiner, appointed under the 67th rule in equity, as amended by the circuit court of the United States for the southern district of Ohio, in the cause stated in the caption, do hereby certify that the foregoing examination was had pursuant to the annexed notice, at the office of Wood & Boyd, No. 53 West 3rd street, Cincinnati, on Tuesday, the sixth day of May, 1873.

I further certify that at said time and place in said caption stated I was attended by Henry J. Reedy, a witness produced on behalf of the complainant, he being of lawful age and sound mind, and the said witness was, previous to the commencement of his deposition, carefully examined, cautioned, and solemnly sworn to testify the truth, the whole truth, and nothing but the truth, and the deposition hereinbefore appearing was by me reduced to writing in the presence of the said witness, and was read over by me to the said witness, and thereupon subscribed by him in my presence.

59 I further certify that I am not of counsel or attorney, or relative of either of the parties to the cause, or in any manner interested in the event of the same.

In testimony whereof I have hereunto set my hand this sixth day of May, A. D. 1873.

HERMAN MERRELL,
Special Examiner.

And afterwards, to wit, on the 5th day of June, in the year last aforesaid, an entry was made upon the journal of said court in said cause, in the words and figures following, to wit:

Entry.

HENRY J. REEDY
vs.
GEORGE SCOTT. } 1434. Chancery.

This day this cause came on to be heard, and was argued by counsel and submitted; and the court take the same under advisement.

And afterwards, to wit, on the 6th day of June, in the year last aforesaid, an entry was made upon the journal of said court, in said cause, in the words and figures following, to wit:

Entry.

HENRY J. REEDY
vs.
GEORGE SCOTT. } 1434. Chancery.

This cause came on for hearing upon the complainant's bill and supplemental bill, and the plea of the defendant thereto, the bill of complaint by way of amendment and further supplement, and the plea of the
60 defendants and answer in support of the same to the said bill, exhibits, and testimony, and was argued by counsel; and thereupon, by leave of the court first had and obtained, the defendant comes and amends his said plea as follows, to wit, in the allegation contained in the following words: "The said Fisher afterwards, to wit, on the 21st day of January, 1871, made and published his decision and award therein in writing," striking out the words "in writing," which amendment is allowed and made; and thereupon the court, being fully advised thereon, find that the said plea is true and sufficient, and that the equity of the case is with the defendants. It is thereupon ordered, adjudged, and decreed that the bill of the complainant and the supplemental bill and bill by way of amendment, and fourth supplement thereto, be and the same are hereby dismissed, and that the complainant pay all the costs of this cause, to be taxed within ten days from the date of this entry; and in default thereof execution is awarded therefor as upon judgments at law. And complainant prays an appeal, which is allowed, and the bond fixed at $500.00.

And afterwards, to wit, on the 14th day of June, in the year last aforesaid, there was filed in the clerk's office of said court the appeal-bond of complainant herein, which said bond is in the words and figures following, to wit:

Appeal-bond.

Know all men by these presents that we, Henry J. Reedy and Henry Schmutte, of Cincinnati, Hamilton County, Ohio, are held and
61 firmly bound unto George Scott in the sum of five hundred dollars, to be paid to the said George Scott, his executors, administrators, or assigns, for which payment well and truly to be made we do bind ourselves, our heirs, executors, and administrators, sealed with our seals, and dated this fourteenth day of June, A. D. 1873.

The condition of the above obligation is such, that whereas the said Henry J. Reedy filed his bill of complaint against said George Scott in

the circuit court of the United States for the southern district of Ohio, in cause No. 1434; and whereas on the pleadings and proofs filed, the said court found that the equity of the case was with the defendant, and thereupon dismissed said bill and supplements, to which said Reedy excepted, and was allowed leave to appeal to the Supreme Court of the United States: Now, therefore, if the said Reedy shall prosecute said appeal with effect, and shall pay all costs which shall be finally awarded or taxed in case said decree shall be affirmed by said Supreme Court, then the above obligation shall be void; otherwise to remain in full force.

HENRY J. REEDY. [SEAL.]
HENRY SCHMUTTE. [SEAL.]

62 THE UNITED STATES OF AMERICA,
Southern District of Ohio, ss:

I, Thomas Ambrose, clerk of the circuit court of the United States within and for said district, hereby certify the foregoing transcript to be truly taken and copied from the files and record of said court in said cause as the same remain in this office.

In testimony whereof I have hereunto set my hand and affixed the seal of said court at Cincinnati, this 23d day of June, A. D. 1873, and in the 97th year of the Independence of the United States of America.

Attest:
[SEAL.]

THO'S AMBROSE,
Clerk Cir. Court.

(Indorsement on cover:) No. 452. Henry J. Reedy, appellant, vs. George Scott. S. Ohio C. C. U. S. Filed 19th July, 1873.

Supreme Court of the United States,

DECEMBER TERM, 1874.

HENRY J. REEDY, Complainant & Appellant,

against

GEORGE SCOTT.

Appeal from the Circuit Court for the Southern District of Ohio.

ABSTRACT, POINTS, AND ARGUMENT FOR THE APPELLANT.

GEORGE E. PUGH.

J. R. MILLS & CO., PRINTERS, CINCINNATI.

Supreme Court of the United States,

DECEMBER TERM, 1874.

HENRY J. REEDY, Complainant & Appellant,

against

GEORGE SCOTT.

Appeal from the Circuit Court for the Southern District of Ohio.

ABSTRACT, POINTS, AND ARGUMENT FOR THE APPELLANT.

ABSTRACT.

On the 20th of January, 1871, the appellant filed his bill of complaint, in equity, alleging the proper grant and delivery to himself, as inventor, of certain letters patent of the United States, No. 78,829, dated the 9th day of June, 1868, for an improvement in hoisting-machines; which letters had been recorded in the Patent Office, and an "exemplified copy of which" the complainant was ready and willing to produce in Court when required.

The bill contains the usual averments of novelty, utility, reduction to practice, etc. It then avers that the defendant, George Scott, knowingly and without leave had, since the 9th of June, 1868, infringed the right of the complainant by making, using, and vending to others to be used, within the domain of the United States, machines which "in principle and mode of operation" were the same as those described in the letters patent aforesaid.

The bill avers, also, that the complainant is engaged at Cincinnati, Ohio, in making and selling machines of which his improvement forms an essential part; that the several acts of infringement by the defendant, as above stated, are injurious to him (the complainant) and, if continued, will destroy his trade and business; that he does not know the exact number of machines which the defendant has unlawfully made and sold; that the defendant, although informed as to the right of the complainant under the letters patent aforesaid, refuses to quit his infringement thereof, and is about to enlarge his making and selling of such machines.

The prayer of the bill is for a writ of subpœna, a discovery, an account, a preliminary injunction, and, upon the final hearing of the cause, for special and general relief.

The bill was sworn to, October 13th, 1870.

A writ of subpœna was issued on the day of the filing of the bill, January 20th, 1871; and was served upon the defendant, personally, at half past three o'clock in the afternoon.

March 8th, 1871, the defendant having failed to answer, it was ordered that the bill should be taken as confessed.

On the next day this order was set aside, and the complainant had leave to file, and did file, a supplemental bill.

ABSTRACT OF THE SUPPLEMENTAL BILL.

It relates the substance of the original bill upon the letters patent, No. 78,829, dated June 9th, 1868, and the infringement by the defendant, George Scott, of the right intended to be secured to the complainant by those letters.

It avers that the defendant, although required to answer, is in default.

It avers, "by way of supplement," that, since the filing of the original bill, the complainant has made a surrender in due form of the letters patent dated June 9th, 1868, for the purpose of obtaining a re-issue of the said letters upon an amended specification, drawings, etc. And that, on the 21st day of February, 1871, such a re-issue was granted by the Commissioner of Patents for the same invention; which letters re-issued, No. 4,273, are of record in the Patent Office.

It avers that the defendant has, without leave, and since the date of the re-issued letters patent, made, used, and sold to others to be used, within the domain of the United States, hoisting machines which comprise the invention of the complainant as described and intended to be secured by the letters patent last mentioned.

The bill prays that the case which it states be taken into consideration with reference to the prayer of the original bill; that the defendant be required to answer upon oath, as if interrogated specially, etc.

This bill was verified in due form, March 8th, 1871.

On the 9th of May, 1871, the defendant, by leave, pleaded to the supplemental as well as to the original bill of complaint.

ABSTRACT OF THE PLEA.

That on the 20th of January, 1871, after the filing of the bill of complaint, an agreement in writing of that date was made by the parties, under their hands and seals, reciting that whereas the complainant was the owner of letters patent No. 78,829, for an improvement in hoisting machines, granted June 9th, 1868, and whereas the defendant was the owner of letters patent No. 81,299, for an improvement in elevators, dated August 18th, 1868, and was building hoisting machines which he claimed to manufacture under said patent and a pending application, but which were claimed by the complainant to be an infringement of his letters patent No. 78,829, and whereas the complainant had filed a bill in equity against George Scott, the defendant, Case No. 1,434, in the Circuit Court of the United States for the Southern District of Ohio, and whereas the parties were desirous of avoiding the expense and delay of litigation, it was thereby, then and there, between the complainant and the defendant mutually agreed to submit to Samuel S. Fisher the question whether the machine manufactured by the defendant was or was not an infringement of the letters patent No. 78,829, and to abide by his decision of said question; that is to say, if Fisher should decide said machine to be an infringement, the defendant agreed to abandon the manufacture of said machines, and to make no more of them in any part of the United States; and, if Fisher should decide that said machine is not an infringement of said patent, then the complainant agreed that the bill in said suit No. 1,434 should stand dismissed at his cost, and that he would not molest the defendant in the manufacture of said machines.

That the bill in equity mentioned in the agreement was the original bill of complaint in this suit.

That, in pursuance of said agreement, the complainant and the defendant personally appeared before Samuel S. Fisher, on the day aforesaid, at Cincinnati, and then and there submitted to him for his arbitration and decision the said question and their respective claims in reference thereto, and their said patents, the said Fisher having then and there taken upon himself the burden of said arbitration; and, the parties having been fully heard by him upon the same, the said Fisher thereupon, afterward, "to wit," on the 21st day of January, 1871, made and published his decision and award therein, in writing, wherein he found and decided, in answer to the question so submitted to him as aforesaid, that the machine manufactured by the defendant was not an infringement of the letters patent No. 78,829, for an improvement in hoisting machines, granted to Henry J. Reedy, the complainant, June 9th, 1868; a copy of which decision, finding, and award was thereupon immediately by the said Fisher delivered to each of the parties. And by reason thereof the complainant became and was bound to cause his original bill herein to be dismissed at his cost, and not further to molest the defendant in the manufacture of the said machine.

The plea was certified by counsel, and accompanied by the proper affidavit, April 22d, 1871.

On the 26th of May, 1871, the complainant had leave of the Court to file, and did file, a second supplement to his original bill and an amendment to his first supplement.

ABSTRACT.

That the complainant, after the filing of his original bill, on or about the 20th of January, 1871, at the request and suggestion of the defendant, accompanied him (the defendant) to the office of Samuel S. Fisher, a solicitor of the Court,

for the purpose of hearing the opinion of said Fisher upon the question of infringement stated in the said bill; that, after a statement of the complainant's claims under his original patent, it was agreed between the parties to submit in writing the whole question of said infringement for the opinion of said Fisher; that Fisher then drew an agreement in writing which the complainant and the defendant signed, but which the complainant did not understand as making the farther prosecution of this suit dependent on the opinion so to be given; that the complainant executed the agreement without consulting his solicitors, and without knowing its effect; that as soon as he became advised of the nature of the agreement and its possible effect, on the morning of the 21st day of January, 1871, said agreement having been executed in the evening of the previous day, he went to the office of Fisher for the express purpose of revoking any and all authority given to him (Fisher) by the said agreement, but Fisher was not in his office, and the complainant was informed that he (Fisher) would not be in the city until late in the afternoon; that the complainant then took away from Fisher's office the original letters patent, and did not return them; that in the afternoon of the said 21st day of January, 1871, and before the making or signing of the pretended award hereinafter mentioned, the complainant saw Fisher at his office and explained to him that he (the complainant) was mistaken as to the nature and effect of the agreement, and that he did not wish said Fisher to act thereunder, and, at the same time, served him (Fisher) with a written notice revoking all authority and power given to him (Fisher) by said agreement; that, notwithstanding such revocation and the withdrawal of the letters patent, which were the only evidence of the complainant's invention before him, Fisher proceeded in the matter of said reference, and afterward made and delivered an opinion with respect to the infringe-

ment by the defendant of the first claim of the letters patent, but did not give any opinion or make any award as to the second claim (for an infringement of which, as well as of the first, this suit was brought) and did not award, adjudge, or direct anything to be done by either of the parties; that the complainant was not notified of the sittings of said pretended arbitrator, nor was any opportunity given him to call witnesses, or to be heard in person or by counsel; and that it does not appear that the machine of the defendant was before Fisher, or that any evidence respecting the same was offered or by said Fisher required.

Prayer as in the bill and first supplement. Verification in due form, May 23d, 1871.

June 14th, 1871, the defendant again pleaded, with an answer in support of his plea.

COPY.

This defendant now comes, and, as to the said bill of complaint and supplemental bill, and bill by way of amendment and further supplement thereto, of the said complainant, doth plead thereto, and for plea thereto doth re-file his plea heretofore filed to the said bill of complaint and supplemental bill.

And, in support of said plea, and by way of answer to the matters and things set forth and contained in the said bill by way of amendment and of further supplement of the complainant, says that it is not true, as therein alleged, that the complainant signed the said agreement to submit the said question to the decision of the said S. S. Fisher not understanding the same to make the further prosecution of said suit dependent on said decision; and, on the contrary thereof, avers that the complainant signed the same with full knowledge and perfect understanding of the effect thereof, and, particularly, that the very purpose of signing the same was to put an end to this suit. And this defendant,

in further answering, says that it is not true, as therein alleged, that the complainant revoked the authority of said Fisher, given him by said agreement, before said Fisher had made and published said decision and award. And said defendant, in further answering, says that it is not true, as therein alleged, that the complainant was not notified of the sittings of said arbitrator, and that no opportunity was given the complainant to call witnesses or to be heard in person or by counsel; but, on the contrary, he avers that the complainant was personally present before said arbitrator at all his sittings held for the purpose of hearing said cause, and had full opportunity to and did in fact produce and offer all evidence he considered material to his claim, and was fully heard thereon by said arbitrator.

And by reason of the premises the defendant says that the complainant is barred from further prosecuting or maintaining this suit, and prays to be hence dismissed with his reasonable costs.

Verification in due form, June 7th, 1871.

October 12th, 1872, motion to strike out the plea and the answer, "for insufficiency," overruled.

Order for the taking of testimony, March 6th, 1873.

ABSTRACT OF THE TESTIMONY.

Deposition of HENRY J. REEDY, *March 13th*, 1873. *Taken, by request of the parties, upon question and answer.*

1. Am thirty-two years of age; reside on Eggleston avenue, Cincinnati; maker of hoisting machines; complainant in this suit.

2. Acquainted with George Scott, the defendant, personally.

3. Called on S. S. Fisher, at his office, in Cincinnati, for the purpose of asking his legal opinion; this in company with Scott, on or about the 20th day of January, 1871.

4. Scott and I called, that day, in company, on George Johnson; he advised us to call on Fisher, and ask his opinion. Scott was served by the Marshal of the United States, while in Fisher's office, with a writ to answer for the infringement of my letters patent. "We had previously asked Mr. Fisher for his opinion. When Mr. Fisher saw the United States Marshal, he declined to give any opinion except we would sign a paper. Then he wrote a paper, which we signed."

5. I did not attach a seal, or scroll, to my signature. "The paper had no seal."

6. "Please state what documents, if any, you left in the possession of Mr. Fisher for the purpose of enabling him to arrive at an opinion on the question submitted."

Answer. "I left my patent."

7. The paper was dated January 20th, 1871. "The object of the paper was, in case said Scott's hoisting machine was an infringement on my patent, he, Scott, would abandon the making of said machine; and, if not, I was to withdraw the suit in the United States Court."

8. I next saw Fisher in the evening of January 21st. "I then asked Mr. Fisher if he had come to any opinion between myself and Mr. Scott. He said not. I then told him to discontinue any further in the matter for me. He answered he did not know if he could do so without Mr. Scott's consent. I told him I did not care; I wanted him to stop. He said he would continue. I asked him how he would continue, as I had taken my patent away in the morning. He said it made no difference, as he could get my claim from the Patent Office Report; which he took from the shelf, and showed me my claim. I then served him with a written revocation, revoking his authority to proceed any further. I tried to see him on the evening of January 20th, 1871; but he had gone home: that was about five o'clock in the evening. I intended to serve him with a revocation at

that time. I tried, also, on the following forenoon; but he could not be found." Mr. Boyd and I were in Fisher's office in the morning of January 21st, "and I then took my patent paper away from his office." "They told me that Mr. Fisher would be in his office about four o'clock; at which time I served him with the revocation."

9. Copy of the revocation produced, and made an exhibit (No. 1) to the deposition.

"JANUARY 21.

"HON. S. S. FISHER,

"SIR:—The paper which I signed in your office yesterday, referring to my claim against Mr. Scott for infringement of my patent, was not intended to affect my suit against him; and, if it can be so construed, I now desire to hereby revoke all authority given you to act for me in any way.

"I only went to see you at request of Mr. Scott, and for his satisfaction; and, if I signed any paper cutting off my rights in Court, I did not so understand or intend it.

"Your's, &c.

"HENRY J. REEDY."

10. The "notice" was signed by me.

11. I received, "notwithstanding this notice," a paper by mail, January 29th, 1871, "purporting to be the award or decision of Mr. Fisher upon the question submitted to him." "I saw it first on the same day."

12. "He [Fisher] said that, if my patent was re-issued, it would completely cover Mr. Scott's machine."

13. He told me this after the 21st of January, 1871.

Cross-Examination. 1. My application for a re-issue was made before I had read Fisher's award.

2. It was after the agreement of arbitration.

3. It was after the revocation.

4. "Was it the object of your application to cover the machine of Mr. Scott, and make it an infringement of your patent hoisting machine?"

Answer. "It was my object to substantially and clearly state the claims of my invention."

5. "I insist upon your answering whether or not it was the object of your application for a re-issue to cover the machine of Mr. Scott, as examined by Mr. Fisher, and so make it an infringement of your patent hoisting machine."

Answer. "It was not definitely so intended."

6. "By whom was the letter making the pretended revocation written?"

Answer. "By Mr. Boyd, my attorney, I believe."

7. "Was it made after consultation with your counsel; and for what reasons was it made?"

Answer. "I told my counsel that I had signed a paper in Mr. Fisher's office. He told me to revoke it immediately. The reason was to have my patent re-issued, and my invention and claims definitely described."

8. "State if Mr. Scott's visit to Cincinnati, at that time, was not for the purpose of settling these questions in controversy; and whether or not you did not, with Mr. Scott, visit or call upon several persons with the object of submitting this question of infringement to reference."

Answer. "Mr. Scott's visit was not to settle that difference between him and me. He came here to sell his patents. We called on no person in regard to submitting it to reference."

9. "What was your object in calling upon Mr. Fisher?"

Answer. "To get his opinion of the differences between the parties."

10. "Did you not agree to refer the question of infringement to Mr. Fisher?"

Answer. "I did not understandingly."

11. "Did you not pay Mr. Fisher a fee for his services as referee or arbitrator?"

Answer. "I asked Mr. Fisher how much his trouble

amounted to: he answered fifty dollars. I gave him a check for it."

12. "Was this before or after the arbitration by Fisher?"

Answer. "It was before I read his supposed award."

13. "Was it before or after you gave him the letter referred to in question 9 examination in chief?"

Answer. "It was after."

14. "Was the agreement to arbitrate, which you signed in Mr. Fisher's office, read to or by you before you signed it?"

Answer. "It was read by Wm. H. Fisher in the room. I heard it."

15. "Did not Mr. Fisher refuse to proceed further in the matter unless you would agree to have the suit which you had brought against Scott dismissed in case his award should be against you and your patent?"

Answer. "He inserted that in the agreement. I don't remember whether he refused to proceed unless I agreed to that."

16. "Did he not refuse to proceed unless you would sign the paper that he drew up as an agreement to arbitrate?"

Answer. "I don't know that he did refuse."

17. "Was it not a condition in that paper that, if the award should be in favor of Scott, you would dismiss the suit you had brought against him, and that you would not molest him in the further manufacture of his machine?"

Answer. "I believe there were such conditions stated in the agreement."

18. "Did you sign the paper?"

Answer. "I did, but not fully understanding its contents or importance."

19. "Who is the George Johnson whom you referred to in answer to question 4 of examination in chief?"

Answer. "He was a manufacturer of hoisting machines,

on Columbia street, at the American Machine Shop. I do not know where he is now."

20. "Had you any reason to think or know that the decision of Fisher would be adverse to you when you attempted to revoke his authority?"

Answer. "I had no reason to know or think so."

21. "Was your suit against Scott commenced before or after you went with him to see Mr. Fisher, on the 20th of January, 1871?"

Answer. "It was commenced before the Marshal served him in the office of Mr. Fisher."

Re-Examination. 1. Have seen a copy of the paper which I signed in Fisher's office, since the day of its signature; a copy, not the original.

2. My statement in cross-examination, as to the contents of the paper, is from having recently read a copy of it. "I never did understand that paper until about six months ago."

Question upon the part of the Defendant. "Please state if you have a copy of the agreement to award and arbitration in your possession, or the possession of your attorneys; and can you produce the same, and make it a part of your deposition?"

(Witness advised by his counsel present, Mr. Boyd, "that he is not bound to, and need not, produce and make a part of his deposition the paper called for in the question." Objection to this by the counsel for the defendant.)

Answer. "It is not in my possession." Is in the possession of one of his counsel, Mr. Pugh, not present. "I refuse, upon the advice of my counsel, to make said copy a part of my deposition."

TESTIMONY FOR THE DEFENDANT.

Deposition of SAMUEL S. FISHER, *April 2d*, 1873. *Taken, by request of the parties, upon question and answer.*

1. Forty years of age; reside in Cincinnati; attorney at law by occupation.

2. "For the last seventeen years I have been engaged specially in the conduct and trial of cases arising under letters patent for inventions, and for the last ten years have accepted no other business."

3. Acquainted with the parties to the suit.

4. "Please state whether or not, on or about the 20th of January, 1871, the plaintiff and the defendant in company called upon you, at your office, for the purpose of asking your opinion in reference to the dispute between them with regard to patent elevators; if so, please state the object of their call, as expressed to you by them, and also state what was done in your office at that time." *Answer.* "On the evening of the 19th of January, 1871, the parties named in the question called in company at my office, in this city, and asked me if I could hear a case between them in relation to a hoisting machine. I had never seen either of the parties before; and, at first, I was reluctant to hear the matter in controversy, stating to them that people were very rarely satisfied with the result of arbitrations. After some conversation I agreed to sit as referee; but either the parties or myself were not ready to go on at the moment, and the matter was adjourned until the following day. The next day Mr. Scott came to the office a little in advance of Mr. Reedy; and, shortly afterward, a deputy marshal entered and served him with a subpœna in the present cause. Mr. Reedy was not, I think, present at the time of service; but came in a few moments later. The subpœna was shown to me, and I declined at once to proceed with the proposed

arbitration; expressing some indignation that my office should have been used for the purpose of obtaining service on Scott after the proposal of the day before. Mr. Reedy, however, assured me that it was his desire that the arbitration should go on, and that all matters in controversy between the parties should be settled by me without the expense of litigation. He said that the suit had been brought, and the service made on Scott, by the advice of his counsel; so that, in case there should be a failure to carry out the arbitration, he would have service upon Scott, who was a non-resident. After some conversation, at the request of both parties, I drew up an agreement, under seal, which was signed by them; which agreement was read to both parties once, and I think two or three times, and, in addition, its effect was verbally explained to them, the verbal explanation being to this effect. To Scott I said: 'You understand, if I decide against you, you must quit the manufacture of these machines; not only in this city, but every where.' And to Reedy I said: 'If I decide against you, you must dismiss this suit immediately, and let Mr. Scott alone.' Both parties stated that they so understood the matter. The parties then left, and I examined the case, which was submitted to me upon the patent of Reedy and a model of the Scott machine. I think it was in the afternoon of the same day that the parties returned again to learn my decision. Although I had determined the case, I had prepared no written award; but proceeded to state to them, verbally, the conclusion to which I had come, accompanying it with an elaborate explanation and illustration of the law of combinations. I took great pains to make this as plain as I could; and both parties seemed, at length, to understand and be satisfied with it. The next day I prepared a written opinion; a copy of which was made for both parties, and subsequently delivered to each of them. I charged them $100

for the service. Mr. Scott paid the amount at once; Mr. Reedy some short time after."

5. "Exhibit S. S. F., No. 1, is the original agreement made by Henry J. Reedy and George Scott in my presence, and referred to in my last answer, and Exhibit S. S. F., No. 2, is the original draft of my opinion and award in the case submitted to me by them. I make them a part of this deposition. Both papers are in my handwriting."

6. "Will you please state whether or not Mr. Reedy ever revoked your power to arbitrate this question; if so, how did he revoke it, and when?" *Answer.* "Mr. Reedy served me with a paper which I have not preserved; but which, as I recollect it, did purport to revoke his agreement to submit the matter to arbitration upon the ground that he did not understand his right to carry on the suit to be submitted as a result of the decision. This paper was handed me after the interview, in the presence of both parties, when I announced to them verbally the conclusion to which I had come, and, as I now recollect, after the draft of the award had been prepared and signed, but before it was copied or delivered to either of the parties."

CROSS EXAMINATION.

1. "Was it not in the afternoon of January 20th, 1871, that the paper marked S. S. F., No. 1, was executed?" *Answer.* "It may have been so. I have no independent recollection of these dates, except as I have refreshed my memory by the papers themselves. I recollect the order of the transactions; but cannot now undertake to say, except as a matter of impression, at what time of day each took place."

2. It was executed after the service of the writ of subpœna.

3. Do not recollect the time of leaving my office on that day, or whither I went subsequently.

4. "Do you remember that you were not in your office until late in the afternoon of the following day?" *Answer.* "I have no recollection of that fact."

5. "Are you certain that Mr. Reedy returned to your office on the 20th of January, 1871, after executing Exhibit S. S. F., No. 1?" *Answer.* "I am not certain that it was on the same afternoon that the parties returned, though that is still my impression. I only wish to be understood as saying that they did return before I prepared my draft-opinion."

6. "How long after the preparation of Exhibit S. S. F., No. 2, was it before the copies were delivered to the parties?" *Answer.* "I think Mr. Scott received his on the following day. I can give this date exactly, if desired, upon an examination of my books. I do not recollect how soon the opinion was delivered to Reedy. I have the date at which he paid his proportion; but, as he subsequently became a client, and we did other business for him, the date of payment would not be a certain criterion of the date of delivery as in case of Scott. I should think the opinion was delivered to Reedy a week or ten days after it was prepared. It may have been less or more."

7. "Between the 21st of January, 1871, and the delivery of the copy of Exhibit S. S. F., No. 2, did you advise Mr. Reedy that the original was executed by you; and, if so, did you show it to him?' *Answer.* "I did advise Mr. Reedy of the award at the time that he called upon me to serve the notice of revocation. After reading the notice I expressed some surprise at the statement therein that the dismissal of the suit was not involved. I remember saying: 'You don't mean to tell me, Reedy, to my face, that you did not fully understand that you were to dismiss the suit!"

He laughed, and said his counsel had told him that he ought to sign that paper and give it to me. I replied that I did not think I could regard it; that my decision was made; and I thought Mr. Scott had acquired such rights that I ought now to publish the decision."

8. "Were you not, at the time Mr. Reedy served you with the notice of revocation, examining Patent Office Reports; and did you not, in reply to a question by Mr. Reedy as to how you could proceed after he had withdrawn his patent, say in substance that the withdrawal of his patent would not make any difference as you had the claim of his patent in the reports?" *Answer.* "I have no recollection of the fact inquired of. I have frequent occasion to consult Patent Office Reports, and may have been examining them. I should not have ventured to decide the rights of any man under a patent upon a mere inspection of the claims; although I believe that, in drafting my opinion, I copied the claim in controversy from the printed report."

9. "Did you copy the claim, in your opinion, after Mr. Reedy served you with the notice?" *Answer.* "I think not. Mr. Reedy came into the office during my absence from it, and took away his letters patent. Upon my return, being advised of that fact by my partner, I thought it my duty to draw up the opinion and award at once; copying the claim, as I have stated, from the report. It was subsequent to this date that Mr. Reedy returned, and served me with the notice, as I now recollect."

10. Cannot tell at what time of the day, on the 21st of January, 1871, I first appeared in my office. "I usually reach my office a few minutes before ten o'clock in the morning. I know of no reason why I should have been either earlier or later on that day than usual."

11. "Please explain what you mean by your language, in answer to 7th X-question, 'I ought now to publish the

decision.'" *Answer.* "To deliver copies of the award to each of the parties."

12. "You have stated that you did other business for Mr. Reedy. You will now please state if you advised the surrender of the original patent, No. 78,829, for the purpose of obtaining a re-issue of the same. If you answer yea, you will please state further whether this was subsequent to the signing of the draft-opinion, Exhibit S. S. F., No. 2."

Answer. "I did advise the surrender and re-issue of the patent named in the question; and an application was made, and re-issue obtained, through our office. I think I drew the claims. This advice was given, and application made, after the signing of the draft-opinion, S. S. F., No. 2."

13. "Did you state to Mr. Reedy, in substance, that a re-issue would completely cover Scott's machine?"

Answer. "I think not. I understood the Scott controversy to be terminated; but I advised Mr. Reedy that a re-issue would cure the defect that had prevented him from covering Scott's machine, and secure to him what appeared to be his real invention."

EXHIBIT S. S. F., No. 1, TO MR FISHER'S DEPOSITION.

Whereas Henry J. Reedy is the owner of letters patent No. 78,829, for an improvement in hoisting machines, granted June 9, 1868; and whereas George Scott is the owner of letters patent No. 81,299, for an improvement in elevators, dated August 18, 1868, and is building hoisting machines claimed to be manufactured under said patent and a pending application, but which it is claimed by said Henry J. Reedy are an infringement of his aforesaid letters patent No. 78,829; and whereas said Reedy has filed a bill in equity against said Scott, in Case No. 1,434, in the Circuit Court of the United States for the Southern District of Ohio; and whereas the parties are desirous of avoiding the expense and delay of litigation:

Now, therefore, the said Henry J. Reedy and George Scott have mutually agreed to submit to Samuel S. Fisher

the question whether the machine manufactured by said Scott is or is not an infringement of the said letters patent No. 78,829, and to abide by his decision of said question. That is to say: If said Fisher shall decide said machine to be an infringement, the said Scott agrees to abandon the manufacture of said machines, and to make no more of them in any part of the United States; and, if said Fisher shall decide that said machine is not an infringement of said patent, then said Reedy agrees that the bill in said suit, No. 1,434, shall stand dismissed at his costs, and that he will not molest the said Scott in the manufacture of said machine.

Witness our hands and seals, this twentieth day of January, 1871.

HENRY J. REEDY. [SEAL.]

Witness: GEORGE SCOTT. [SEAL.]

WM. H. FISHER.

Exhibit S. S. F., No. 2, to Mr. Fisher's Deposition.

HENRY J. REEDY
v.
GEORGE SCOTT.
} *Arbitration.*

This case is submitted to me for decision as referee. The question presented by the agreement of the parties is whether the machine manufactured by George Scott is or is not an infringement of the letters patent No. 78,829, for an improvement in hoisting-machines, granted to Henry J. Reedy, June 9, 1868.

The patent embraces two claims, but the controversy as to infringement is, by agreement, limited to the first; which reads as follows: "The combination, substantially as described, with a hoisting platform of the suspending ropes E., weights H. H., rollers d., sheaves F. F., and shaft G., or their mechanical equivalents, by which the platform is both balanced and enabled to be elevated and depressed in the manner explained."

The mechanism involved in this claim may be briefly described as follows: The platform of an ordinary hoisting-machine is suspended in the bight of a long rope, about at

mid-length of the latter. The two ends of the rope pass up, one on each side of the hatchway, to a sheave; the two sheaves being secured to the same horizontal shaft, which is caused to rotate by gearing. After passing over the sheaves, each end of the rope descends, and is attached to a weight or counterpoise. At the point where the rope passes under the platform a small roller is located, one on each side, to prevent the abrasion of the rope as it is drawn backward or forward. The rope may be caused to move under the platform by irregularities in the load, or by one sheave taking up the rope faster than the other; and the purpose of passing the rope below the platform, and of making provision to prevent its abrasion, is that by using the rope in this way the platform is more perfectly balanced under all conditions. Hence, the claim describes the mechanism not only as raising and depressing the platform, but as "balancing" it; and it is in the performance of this latter function that the rollers, d., play their especial part.

The machine of Scott shows a platform hung in the bight or loop of a rope which passes under a beam directly over the centre of the platform, with which it is connected by two side stanchions. The ends of the rope are taken up to two sheaves on the same horizontal shaft, over which they pass, descending over two idle pulleys on one side of the machine to a single weight, to which both ends are fastened. At the point at which the rope passes under the beam of the platform there is a grooved metallic saddle, which holds up the ends of two levers which operate the safety-brake; the rope passes in the groove around this saddle, and in fact suspends the saddle in the loop or bight.

In my judgment, in so far as the function of elevating or depressing the platform by means of two ropes passing over two sheaves and attached to weights is involved in Reedy's claim of invention, the same function is performed, in substantially the same way, by the mechanism of Scott's machine. But Reedy's claim is not for the mechanism for elevating and depressing the platform, disconnected from that for balancing it. On the contrary, the mechanisms for

performing the two functions are claimed in combination, and not otherwise.

It is well settled law that a patent for a combination is not infringed unless all the parts of the combination are used by the alleged infringer. He must use every element enumerated, or must substitute a substantial equivalent for those omitted. The cases upon this subject are all one way. (Pratz *v.* Ruggles, 16 Peters, 336; Vance *v.* Campbell, 1 Black, 427; Crompton *v.* Belknap Mills, 3 Fisher, 536.)

After careful examination, I do not think that Scott uses the rollers, d., or any equivalent for them. His rope does not pass under the platform. As the ends are not attached to separate weights, but to the same weight, there is no movement of the rope. It does not play any part in balancing the platform; which is simply suspended as from a single central point. He does not use a roller, but a grooved piece of metal; and while it is true that such a curved piece of metal, placed in the same place as the roller, d., and aiding the rope in balancing the platform by diminishing the friction, would probably be an equivalent for the roller, yet I am clearly of opinion that, used as it is in Scott's organization, merely to enclose and sustain the ends of the brake-levers, and performing no part in balancing the platform, or in preventing the abrasion of the rope, it is not an equivalent of the rollers. It follows that Scott has omitted a material element of the combination patented to Reedy, and, consequently, has not infringed his patent.

I therefore find, in answer to the question submitted to me, that the machine manufactured by George Scott is not an infringement of the letters patent No. 78,829, for an improvement in hoisting-machines, granted to Henry J. Reedy, June 9, 1868.

SAM'L S. FISHER, *Referee.*

January, 21, 1871.

REBUTTING TESTIMONY FOR THE COMPLAINANT.

Deposition of HENRY J. REEDY, *May 6th*, 1873. *Taken, by request of the parties, upon question and answer.*

1. "You are the complainant who testified hereinbefore; are you not?" *Answer.* "I am."

2. "State whether, after signing the submission, Exhibit S. S. F., No. 1, on January 20th, 1871, and leaving Mr. Fisher's office, you returned in company with the defendant, or there met the defendant again; and, if so, when and how often?" *Answer.* "I did not return in company with the defendant, nor did I meet him there afterwards."

3. "State whether Mr. S. S. Fisher at any time informed you and the defendant together, either verbally or otherwise, of his determination of the question submitted by said Exhibit S. S. F., No. 1." *Answer.* "He did not."

4. "I find the following in answer 4 of Mr. Fisher's deposition herein: 'I think it was in the afternoon of the same day that the parties returned again to learn my decision. Although I had determined the case, I had prepared no written award; but proceeded to state to them, verbally, the conclusion to which I had come, accompanying it with an elaborate explanation and illustration of the law of combinations. I took great pains to make this as plain as I could; and both parties seemed, at length, to understand and be satisfied with it.' What do you say as to the truth of this quotation?" *Answer.* "Myself and Mr. Scott were not in company in his office, or did he give me notice of his decision. There was no such explanation or illustration given, nor was there any."

5. "Were you present when the Deputy Marshal served

the defendant in this cause with subpœna to appear and defend?" *Answer.* "I was. The Marshal asked for Mr. Scott, and I pointed him out to the Marshal in Mr. Fisher's office."

6. "Mr. Fisher in his deposition, now shewn you, says that you said that suit had been brought and the service made on Scott, by the advice of your counsel, so that, in case there should be a failure to carry out the arbitration, you would have service upon Scott, who was a non-resident. What do you say to this; and what steps, if any, had you taken in the cause prior to your interview with Mr. Fisher?" *Answer.* "I did not say that was the object of bringing the suit. I had instructed my counsel, in the fall of 1870, to bring the suit and have service on Mr. Scott.

7. "What was the nature of your interview with Mr. Fisher up to the time of the service by the Marshal? Was it then changed; and who suggested the agreement to arbitrate?" *Answer.* "The nature of our interview was, we wanted Mr. Fisher's verbal opinion. But when the Marshal served Mr. Scott, Mr. Fisher suggested that he should draw up a writing; and he then drew up the Exhibit, S. S. F., No. 1."

8. "About what time of day was this exhibit signed, as near as you now recollect?" *Answer.* "Between four and five o'clock in the afternoon."

9. "When did you next see Mr. S. S. Fisher?" *Answer.* "I saw him in the evening of the following day, when I served him with the revocation."

10. "How often did you call at his office between the time of signing Exhibit S. S. F., No. 1, and the service of the revocation on the following day? Whom did you see, and what were you told with reference to Mr. Fisher's absence, whereabouts, and probable return?" *Answer.* "I called on the evening of the 20th, twice in the forenoon of

the 21st, and two times in the afternoon. Once I didn't find him, and once I did find him. The office was closed on the evening of the 20th, and I saw no one. In the morning of the 21st I saw Mr. Wm. H. Fisher, Mr. S. S. Fisher's law partner. He told me Mr. S. S. Fisher was in College Hill, visiting friends, and that he would not return before evening. On my first call, in the afternoon, I asked Mr. Wm. H. Fisher if he had returned; and he told me he had not."

11. "You will please read Mr. Fisher's answer to cross-question 7, and state whether or not the statements there related were ever made, and more particularly whether, at the time you served him with the revocation, he advised you of the award and said he ought to publish it." *Answer.* "He did not advise me of the award at that time; he had no award made. I don't remember any such statements being made. I asked him if he had come to any opinion, and he said not."

12. "When did he first advise you of the award, and what did he say?" *Answer.* "I called at his office on the 23d of January, 1871, to pay him for his trouble; and he then told me he had decided against me. This was the first I heard or knew of his opinion. I gave him a check for the amount, which I now have."

13. "What, if any thing, was then said by him as to the defendant having not paid his share of the charges?" *Answer.* "I asked him if the defendant paid him. He said not; his model was in the office yet."

14. "Did you, at any time after, see the defendant's model in Mr. Fisher's office; and, if so, what reason, if any, was assigned for its presence there?" *Answer.* "I saw the model there. I understood from parties in the office, I don't know who, that he had to send to Louisville for money to pay his share."

DECREE OF THE CIRCUIT COURT,

June 6th, 1873.

This cause came on for hearing upon the complainant's bill and supplemental bill and the plea of the defendant thereto, the bill of complaint by way of amendment and further supplement and the plea of the defendant and answer in support of the same to the said bill, exhibits, and testimony, and was argued by counsel; and thereupon, by leave of the Court first had and obtained, the defendant comes and amends his plea as follows, to wit, in the allegation contained in the following words: "The said Fisher afterwards, to wit, on the 21st day of January, 1871, made and published his decision and award therein in writing," striking out the words "in writing," which amendment is allowed and made. And thereupon the Court, being fully advised thereon, find that the said plea is true and sufficient, and that the equity of the case is with the defendant. It is thereupon ordered, adjudged, and decreed that the bill of complaint and the supplemental bill and bill by way of amendment and further supplement thereto be and the same are hereby dismissed, and that the complainant pay all the costs of this cause, to be taxed within ten days from the date of this entry, and in default thereof execution is awarded therefor as upon judgments at law.

And the complainant prays an appeal; which is allowed, and the bond fixed at five hundred dollars.

Bond executed, with surety, June 14th, 1873.

ERRORS ASSIGNED UPON THE DECREE.

1. The Circuit Court held the plea of the defendant to be true and sufficient with respect to the matters alleged in the supplemental bill.

2. The Circuit Court found the equity of the cause, with respect to the matters alleged in the supplemental bill, to be with the defendant.

POINTS.

I. The award of Mr. Fisher cannot be so construed, properly, as to impair or in any wise affect the rights of the complainant in virtue of the letters patent as re-issued. Those rights were not within the terms of the submission.

Kyd on Awards, 1st Am. edition, 141, 142.

2 Modern Reports, 309, Hill *v.* Thorn.

Brooke's Abridgement, "Arbitrement," pl. 27 et pl. 50.

2 Curtis, 28, Myers *v.* York and Cumberland Railroad Co.

Same case, on writ of error, 18 Howard, 246.

Effect of the Re-issue:

17 Howard, 74, Battin *v.* Taggert.

9 Wallace, 788, Rubber Co. *v.* Goodyear.

4 Howard, 380, Stimpson *v.* West Chester Railroad Co.

6 Blatchford, 195, Blake *v.* Stafford.

19 Wallace, 433, 434, Klein *v.* Russell.

II. The supplemental bill was, also, a supplemental suit; and, therefore, ought not by the decree to have been dismissed for a cause applicable only to the original bill.

5 Maddock, 427, 428, Catton *v.* Earl of Carlisle.

1 Paige, 168, Candler *v.* Pettit.

3 Story, 749, Woodworth *v.* Stone.

6 B. Monroe, 141, 142, McGrath *v.* Balser.

See, also, 2 Wallace, 609, Minnesota Co. *v.* St. Paul Co. Same case, 6 Wallace, 742.

GEO. E. PUGH,
For the Appellant.

ARGUMENT.

I submit this cause, on the part of the appellant, with the following observations.

I. *As to the first Point.*

Assuming the article of January 20th, 1871, to be conclusive—page 20 of the Record as printed—and that Mr. Fisher made a complete award, in the very terms of the submission, I contend that, nevertheless, the decree of the Circuit Court is erroneous, and ought to be reversed or essentially modified.

The question upon which the parties, Reedy and Scott, desired an opinion by Mr. Fisher was whether the making and selling, to be used, of a certain machine (the model of which was exhibited) did or did not constitute an infringement of the exclusive right secured by letters patent No. 78,829, dated June 9th, 1868.

There was no other question in dispute, between the parties, at that time.

Mr. Fisher decided that although the machine was identical in its mode of operation with that described by the letters in respect to the elevation and the depression of the platform, yet, inasmuch as those devices had only been claimed in combination with a device for balancing the platform, and as the machine of the defendant (Scott) did not include the third element, or a mere equivalent for it, no case of infringement had been shown. The point of the decision is clearly stated by Mr. Fisher in his written opin-

ion. (S. S. F., No. 2, pp. 21, 22, of the Record as printed.) And Mr. Fisher testified that his *verbal* award, upon which the Circuit Court decreed, was to the same effect. "Although I had determined the case, I had prepared no written award; but proceeded to state to them, verbally, the conclusion to which I had come, *accompanying it with an elaborate explanation and illustration of the law of combinations.* I took great pains to make this as plain as I could; and both parties seemed, at length, to understand and be satisfied with it." Record, as printed, page 18.

To construe such an award as extending to a question never submitted, and to a subject matter not then in existence, must needs be—I speak with all deference—a grievous error.

Kyd on Awards, 1st Am. edition, 141, 142:

"The first branch of the general rule is that the award must not extend to any matter not comprehended within the submission.

"Thus, if the submission be confined to a *particular* subject of dispute, while there are other things in controversy between the parties, an award which extends to any of these other things is void, as far as it respects them. [Citing 2 Modern R. 309, Hill *v.* Thorn, 30 Car. II., which is in point.]

"By a submission of all *actions* personal, the arbitrators have no power to make an award of any thing in which the parties have only a *cause* of action. Thus, in case of such a submission, an award 'that one of the parties shall convey E., the servant of the other, to London,' is void unless it appear that an action was depending relative to this servant."

The case here specified (36 Henry VI., 8, 11) is from pl. 27 et pl. 50 of the title "Arbitrement" in Brooke's Abridgement.

Myers *v.* York and Cumberland Railroad Co., 2 Curtis, 28:

SYLLABUS. "A reference of a pending action, under a rule of Court, authorizes the referee to take into consideration only the subject matter substantially shown by the declaration; but he may disregard all such formal defects as might be amended if the case were tried in Court."

Same case, on writ of error, 18 Howard, 246:

SYLLABUS. "If an arbitrator embraces in his award matter not submitted, and includes the result in a single conclusion, so as to render it impossible to separate the matters referred from those which have not been, the award is bad."

The claim of the complainant in virtue of the *new* letters patent, Re-issue No. 4,273,* formed no part of the controversy submitted to the arbitrament of Mr. Fisher on the 20th of January, 1871, as that controversy is narrated in the article of submission. (S. S. F., No. 1, page 20 of the Record as printed.) Nor did Mr. Fisher, himself, so understand. The testimony shows that *after* the verbal award—aye, after the delivery to each disputant of a copy of the written decision, S. S. F., No. 2, pages 21 and 22 of the Record as printed—Mr. Fisher took in hand, as a counsellor at law, the affair of Reedy's invention; that he advised the surrender of letters patent No. 78,829 as defective; that he procured a re-issue of those letters (No. 4,273) upon an amendment of the specification.

Record, as printed, page 20:

Question 12th in the cross-examination of Mr. Fisher. "You have stated that you did other business for Mr. Reedy. You will now please state if you advised the surren-

*The act of Congress approved July 4th, 1836, section 13th, uses the term "new patent" in speaking of re-issue.

der of the original patent, No. 78,829, for the purpose of obtaining a re-issue of the same. If you answer yea, you will please state further whether this was subsequent to the signing of your opinion, Exhibit S. S. F., No. 2."

Answer. "I did advise the surrender and re-issue of the patent named in the question; and an application was made, and re-issue obtained, through our office. I think I drew the claims. This advice was given, and application made, after the signing of the draft-opinion, S. S. F., No. 2."

Question 13*th.* "Did you state to Mr. Reedy, in substance, that a re-issue would completely cover Scott's machine?"

Answer. "I think not. I understood the Scott controversy to be terminated; but I advised Mr. Reedy that a re-issue would cure the defect that had prevented him from covering Scott's machine, and secure to him what appeared to be his real invention."

Mr. Fisher meant, of course, that he had not advised Reedy that letters of re-issue would "cover" acts of infringement previously committed. He meant, also, that his award of January 21st, 1871, required the bill of complaint, *pending at that time*, to be dismissed with costs. The Circuit Court would have made such an order, and properly, on application of the defendant, at any time prior to the filing of the supplemental bill, March 9th, 1871. In *that* sense, might he well have "understood the Scott controversy to be terminated." It *was* terminated—inasmuch as the surrender of letters patent No. 78,829 admitted a defect in the specification.

But, evidently, Mr. Fisher thought the defect was in *specification* merely, and that an amendment would enable Reedy to make good his invention for the future. Let us have those words again: "*I advised Mr. Reedy that a re-issue would cure the defect that had prevented him from covering*

Scott's machine, and SECURE *to him what appeared to be his real invention.*" For, observe, no controversy existed with respect to the interpretation of Scott's letters patent, No. 81,299, "for an improvement in elevators," dated August 18th, 1868, nor with respect to "a pending application" for some other invention. (Record, as printed, page 20.) The dispute was, altogether, in respect to the letters patent of Reedy—prior in date to those of Scott, and preferable (of course) if there had been a conflict. It is plain, upon the evidence, that Mr. Fisher had not the letters patent of Scott before him, nor the claim of the "pending" application. What he had was the model of a *machine* which Scott had been engaged in making and in selling to be used. That machine may have included the invention of Scott, under his letters patent of August 18th, 1868, and even the invention for which he was then seeking other letters; but it included, also, the invention—the "real" invention—of Reedy. Such must have been Mr. Fisher's opinion. But Reedy had failed to describe his invention with sufficient certainty, and therefore was, for the time, at the mercy of Scott.

We have not, in the record, a copy of the specification of Reedy's original letters patent, nor of the specification of the letters as re-issued. But the language of Mr. Fisher's written award, "draft-opinion," is too plain to be misunderstood.

Exhibit S. S. F., No. 2, page 21 of the Record as printed:

> "In my judgment, in so far as the function of elevating or depressing the platform by means of two ropes passing over two sheaves and attached to weights is involved in Reedy's claim of invention, the same function is performed, in substantially the same way, by the mechanism in Scott's machine. But Reedy's claim is not for the mechanism for elevating and depressing the platform disconnected with that for balancing it. On the

contrary, the mechanisms for performing the two functions are claimed in combination, and not otherwise."

Obviously, then, if Reedy had claimed, as his invention, a combination of "the mechanisms for performing the *two* functions" of elevating and depressing the platform, separately from their combination or the combination of either with the mechanism for "*balancing*" the platform, Mr. Fisher would have decided in his favor.

For Mr. Fisher proceeded to say, immediately, on page 22 of the Record as printed:

"It is well-settled law that a patent for a combination is not infringed unless *all* the parts of the combination are used by the infringer. *He must use every element enumerated, or must substitute a substantial equivalent for those omitted.* The cases upon this subject are all one way."

Truly so; and, therefore, assuming the specification to have been rightly construed, there could be no infringement unless the machine of Scott contained the mechanism of Reedy for *balancing* the platform, or "a substantial equivalent" instead, as well as the mechanism for elevating the platform and the mechanism for depressing it. On that subject Mr. Fisher said:

"After careful examination I do not think that Scott uses the rollers, d., or any equivalent for them. His rope does not pass under the platform. As the ends are not attached to separate weights, but to the same weight, there is no movement of the rope. It does not play any part in *balancing* the platform; which is simply suspended as from a single central point. He does not use a roller, but a grooved piece of metal; and while it is true that such a curved piece of metal, placed in the same place as the roller, d., and aiding the rope in balancing the platform, by diminishing the friction, would

probably be an equivalent for the roller, yet I am clearly of opinion that, used as it is in Scott's organization, merely to enclose and sustain the ends of the brake-levers, and performing no part in balancing the platform, or in preventing the abrasion of the rope, it is not an equivalent of the rollers. It follows that Scott has omitted a material element of the combination patented to Reedy, and, consequently, has not infringed his patent."

Whether Mr. Reedy is the true inventor of a combination of the mechanisms described "for performing the two functions" of elevating and depressing the platform, without more, I know not. That question may arise, hereafter, in this case, or in some other. It is a question which Mr. Fisher did not decide, and in respect to which the Circuit Court did not allow the complainant to present his testimony. Therefore, to dismiss a bill (supplemental) founded upon the specification to letters patent, Re-issue No. 4,273, granted the 21st day of February, 1871, in supposed conformity to an award published on the 21st day of January, 1871, when the specification was not in existence, and no application for the Re-issue had been made, seems to me—and here again I wish to speak in all deference—a proceeding without a precedent.

It may be urged that the Re-issue could not lawfully include an invention beyond the scope of the original letters patent. To this I agree; but this cannot mean that an omission to claim, with entire distinctness, what the tenor of the specification shows to have been the "real invention" of the patentee, and what it sufficiently appears he *intended* to claim, must be remediless forever. The very object of the statute in permitting letters patent to be surrendered,

and to be again issued, upon an amended specification, is to provide for such a case.

17 Howard, 74, Battin *v.* Taggert.

9 Wallace, 788, Rubber Co. *v.* Goodyear.

At all events, the validity of the Re-issue ought to be determined upon a question *directly* made.

4 Howard, 380, Stimpson *v.* West Chester Railroad Co.

6 Blatchford, 195, Blake *v.* Stafford.

19 Wallace, 433, 434, Klein *v.* Russell.

It may be urged, also, that the article of January 20th, 1871, stipulated not only for the dismission of Reedy's bill in the Circuit Court for the Southern District of Ohio, but that Reedy would not "molest" Scott "in the manufacture of said machine." This stipulation, however, must be understood with reference to the context and manifest intention of the article. The premises of that are contained in four recitations:

1. That Reedy was the owner of letters patent No. 78,829, for an improvement in hoisting machines, dated June 9th, 1868.

2. That Scott was the owner of letters patent No. 81,299, for an improvement in elevators, dated August 18th, 1868, and was, at the time, "building hoisting machines claimed to be manufactured under said patent [No. 81,299] and a pending application," which machines Reedy alleged to be infringements of "his *aforesaid* letters patent No. 78,829."

3. That Reedy had filed a bill in equity against Scott, Case No. 1,434, in the Circuit Court for the Southern District of Ohio.

4. That the parties were desirous of avoiding the expense and delay of litigation.

"Now, therefore, the said Henry J. Reedy and George Scott have mutually agreed to submit to Samuel S. Fisher the

question whether the machine manufactured by said Scott is, or is not, an infringement of the *said* letters patent, No. 78,829, and to abide by his decision of *said* question."

Mr. Fisher was to take the place of the Judges of the Circuit Court as to the particular "question" submitted; and from his decision there was to be no appeal.

That has been accomplished. The letters patent, No 78,829, have been surrendered; and every cause of action or complaint, *arising under them*, has been abandoned.

"That is to say," continues the article, "if said Fisher shall decide said machine to be an infringement, the said Scott agrees to abandon the manufacture of said machines, and to make no more of them in any part of the United States."

I do not understand, by this, that Scott was to abandon his letters patent No. 81,299, "for an improvement in elevators," dated August 18th, 1868, or even (if that should be allowed) his "pending" application; nor that he should "make no more" hoisting machines. But, only, that he (Scott) should forbear to make *such* machines, without license, as embraced the invention of Reedy described in the "aforesaid" letters patent. He could make them, *under a license*, without violating his agreement.

So in reference to Reedy's covenant:

"And if said Fisher shall decide that said machine is not an infringement of said patent, then said Reedy agrees that the bill in said suit, No. 1,434, shall stand dismissed at his costs, and that he will not molest the said Scott in the manufacture of said machine."

Well, for all important purposes, the "bill in said suit" has been dismissed. There can be no decree upon it as

against Scott; and the liability of Reedy for the costs of it is admitted, in effect, by the allegations of the supplemental bill.

Reedy stipulated not again to sue Scott, or "molest" him, upon the same cause of complaint. He might have sued, but for the agreement, in numerous actions and in several districts. That is all the parties had in view. The question which they *then* had—a question as to the construction of letters patent No. 78,829, "for an improvement in hoisting machines," dated June 9th, 1868—was to be decided in *one* proceeding, namely, the arbitrament of Mr. Fisher.

It cannot be seriously pretended, in case the machines made by Scott should prove to be infringements of other letters patent than those granted to Reedy, No. 78,829, and Reedy should become the assignee of such letters, that he would be precluded, by these terms of agreement, from suing Scott upon a cause of action which might thus accrue. As inadmissible, quite, is it to allege that the agreement includes a cause of action arising upon the Re-issue granted February 21st, 1871, with an amended specification.*

The supplemental bill distinctly avers that the defendant, without the license of the complainant, and against his will, "and in violation of his rights under his said *re-issued* letters patent," has made, used, and vended to others to be used, within the United States, the invention of the complainant, "so patented as *herein* aforesaid," that is, on the 21st of February, 1871—"*all since the date of said re-issue.*" Record, as printed, page 5.

*4 Wallace, 399, Barrows *v.* Kindred.

II. *As to the second Point.*

I have said that the bill in equity pending in the Circuit Court for the Southern District of Ohio, on the 20th of January, 1871, was dismissed, *in effect*, by the filing of the supplemental bill. For the latter set forth, expressly, that the letters patent of June 9th, 1868, had been surrendered, as defective, and (of course) cancelled. Nothing remained except a question of costs; and that needed no plea whatsoever. The Circuit Court would have made an order, at any time, and summarily, for the payment of them.

It is hardly probable, had the defendant objected on the 9th of March, 1871, that the Circuit Court would have granted to the complainant leave to file a supplemental bill. (Page 4 of the Record as printed.) The Court would probably have ordered the original bill to be dismissed with costs. And, possibly, at any subsequent time, until plea pleaded, the Court would, on petition of the defendant, have directed the supplemental bill to be taken from the files; but this must needs have been, I submit, with liberty to the complainant to bring another suit, by original bill, if so advised by counsel, upon the matters set forth in the supplement—the Re-issue (that is) of February 21st, 1871, and any infringement, after that time, of the exclusive rights intended to be secured to the complainant.

These are questions of practice in respect of which the course taken by the solicitor of the complainant may not have been the wisest or the most nearly regular. But the defendant made no objection at the proper time: he did not even insist, before pleading, that a new writ of subpœna should be issued, *and be served*, upon the supplemental bill. 6 B. Monroe, 141, 142, McGrath *v.* Balser.

In truth, as the record shows, the defendant was not placed at any disadvantage by the filing of the supplemental bill; nor could he have been prejudiced, in any degree, by the course of practice adopted. Assuredly, if I am correct in saying that the rights of the complainant under the letters patent (re-issued) of February 21st, 1871, are not within the terms of the submission, January 20th, 1871, and not embraced (as I have shown) by Mr. Fisher's award, the mere fact that the complainant filed a supplemental bill, instead of proceeding by another original bill, is of the least imaginable importance.

The distinction between a supplemental bill, merely, and a supplemental suit—as in the present instance— appears to be well established.

Catton *v.* Earl of Carlisle, 5 Maddock, 427, 428:

"The bill was for the specific performance of an agreement. The answer alleged that it had been agreed that the subject of the suit should be referred. The plaintiff filed a supplemental bill stating that the agreement of reference had failed by a difference between the arbitrators. A general replication was filed, and question was whether this was a replication to the whole record, or only to the original bill."

"The Vice Chancellor held, after referring to the Register, Mr. Croft, that the supplemental bill merely introducing supplemental matter to sustain the relief sought by the same plaintiff from the same defendant by the original bill, was not a supplemental suit, and that there was only one record and one replication, and one cause to be set down."

But see, on the other hand, Candler *v.* Pettit, 1 Paige, 168:

SYLLABUS. "If the original bill was sufficient for one kind of relief, and facts afterwards occur which entitle the complainant to other or more extensive relief, he may

have such relief by setting out the new matter in a supplemental bill."

Woodworth *v.* Stone, 3 Story, 749, is a case where the letters patent described in the original bill were surrendered, and, afterward, a supplemental bill was admitted on the letters as re-issued.

I consider the decree of the Circuit Court a very harsh one. Certainly, if Mr. Fisher's opinion be correct, the defendant has unlawfully used, and continues unlawfully to use, the invention of the complainant; and this without remedy to the complainant, in any form, because the Circuit Court in effect construed the award of Mr. Fisher (contrary to that gentleman's intention) as equivalent to an irrevocable license by the patentee to a man who never gave him, and does not mean to give him, the slightest consideration.

Had the Court dismissed the supplemental bill without prejudice, I should not have murmured; but to dismiss it on the merits, and to find the equity of the cause for the defendant, upon his plea, was and is, in my estimation, an act of great injustice.

GEO. E. PUGH.